Filed on behalf of: Junior Party CONNERY

Paper No. _____

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

GLENN W. **CONNERY**, GARY JASZEWSKI, and RICHARD REID
Junior Party
(Patent 6,246,683)

v.

LAURENCE B. **BOUCHER**, STEPHEN E. BLIGHTMAN,
PETER K. CRAFT, DAVID A. HIGGEN,
CLIVE M. PHILBRICK, and DARYL D. STARR
Senior Party
(Application No. 09/692,561)

Patent Interference No. 105,775 (JL)

(Technology Center 2400)

NOTICE OF APPEAL

1   Pursuant to Federal Rule of Appellate Procedure 15(a) and Federal

2   Circuit Rule 15(a), Glenn W. Connery, Gary Jaszewski, Richard Reid, and

3   real party in interest Hewlett-Packard Company (collectively, "Appellants"),

4   by and through their undersigned counsel, hereby notify the Court of their

5   appeal from the final determination of Board of Patent Appeals and

6   Interferences of the United States Patent and Trademark Office (the "BPAI"),

7   as provided in the following: 1) Order – Miscellaneous – Bd. R. 104(a)

8   issued on November 22, 2010 (the "Order"), 2) Decision – Motions – BD. R.

9   125(a) issued on March 26, 2012 (the "Decision"), and 3) Judgment –

10   Request for Adverse – Bd. R. 127(b) issued on June 18, 2012 (the

11   "Judgment"), all attached hereto. Appellants received the Order on

12   November 22, 2010, the Decision on March 26, 2012 and the Judgment on

13   June 18, 2012. The senior party in the interference was Laurence B.

14   Boucher, Stephen E. Blightman, Peter K. Craft, David A. Higgen, Clive M.

15   Philbrick and Daryl D. Starr (the "Appellees").

     The case was styled before the BPAI as *Glenn W. Connery, Gary*

16   *Jaszewski and Richard Reid (Junior Party) (Patent 6,246,683) v. Laurence B.*

17   *Boucher, Stephen E. Blightman, Peter K. Craft, David A. Higgen, Clive M.*

18   *Philbrick and Daryl D. Starr (Senior Party) (Application 09/692,561)*, Patent

19   Interference No. 105,775.

20   Counsel for Appellants before the Court will be Lynn Pasahow,

21   Carolyn Chang, and Hector Ribera of Fenwick & West LLP, all at 801

22   California Street, Mountain View, CA 94041. Counsel can be reached at

23   (650) 988-8500.

24   Appellants appeal all issues appealable in this case, including but not

25   limited to:

26   1.   Final determination by the BPAI denying Appellants' Motion 1

27

28

Fenwick & West LLP
Attorneys at Law
Mountain View

1   alleging no interference-in-fact.

2   2.   Final determination by the BPAI denying Appellants' Motion 2

3

4   alleging unpatentability of Claims 41-45 of Application 09/692,561 for lack

5   of written description under 35 U.S.C. § 112, first paragraph.

6   3.   Final determination by the BPAI denying Appellants' request

7

8   for a motion on prosecution laches.

9   4.   Final determination by the BPAI entering judgment on priority

10

11   as to Count 1 against Appellants.

12   5.   Final determination by the BPAI that claims 1-3 and 5-20 of

13

14   Appellants' Patent 6,246,683 are cancelled.

15   6.   Final determination by the BPAI entering judgment on priority

16   as to Count 2 against Appellants.

17   7.   Final determination by the BPAI that claim 4 of Appellants'

18

19   Patent 6,246,683 is cancelled.

20

21   Respectfully submitted,

22

23   Dated: July 3, 2012   By :   /Robert Sachs/

24   ROBERT SACHS, Reg. No. 42,120
                                            Attorney of Record for Connery.
25

26

27

28

FENWICK & WEST LLP
ATTORNEYS AT LAW
MOUNTAIN VIEW

PROOF OF ELECTRONIC SERVICE

I am at least 18 years old and not a party to this action. My business address is:

Fenwick & West LLP, 801 California Street, Mountain View, CA 94041.

On July 3, 2012, I served the following document :

NOTICE OF APPEAL

after 6:00 pm, Eastern time on:

Mark A. Lauer (Mark@SiliconEdgeLaw.com) Thomas W. Lathram (Tom@SiliconEdgeLaw.com) Silicon Edge Law Group LLP 6601 Koll Center Parkway, Ste. 245 Pleasanton, CA 94566	ELECTRONICALLY AND VIA FEDERAL EXPRESS
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Office of the Solicitor United States Patent and Trademark Office Mail Stop 8 Post Office Box 1450 Alexandria, VA 22313-1450	VIA U.S. EXPRESS MAIL
Clerk of Court United States Court of Appeals for the Federal Circuit 717 Madison Place, NW Washington, DC 20439	VIA FEDERAL EXPRESS

I declare under penalty of perjury that the foregoing is true and correct.

Dated: July 3, 2012

By: */Justin Hulse/*

Justin Hulse

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

———

GLENN W. **CONNERY**, GARY JASZEWSKI and RICHARD REID
Junior Party
(Patent 6,246,683),
.v.
LAURENCE B. **BOUCHER**, STEPHEN E. BLIGHTMAN, PETER K. CRAFT,
DAVID A. HIGGEN, CLIVE M. PHILBRICK and
DARYL D. STARR
Senior Party
(Application 09/692,561).

———

Patent Interference No. 105,775 (JL)
(Technology Center 2400)

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Before LEE, *Administrative Patent Judge*.

Order -- Miscellaneous -- Bd. R. 104(a)

1   A telephone conference call was held on November 18, 2010, between the

2 administrative patent judge and respective counsel for the parties to discuss each

3 party's proposed motions list. The conference call was transcribed by a court

4 reporter.

5 A.   Boucher's Proposed Motions List Items

6   1.   Boucher is authorized to file a substantive motion alleging

7 unpatentability of Connery's involved claims 1-9 on the ground of either

1 anticipation or obviousness based on Boucher's Provisional Application

2 60/061,809, but may initiate a conference call to request changing the base

3 reference to Boucher's Patent 6,226,680. Each claim, however, shall not be subject

4 to both a charge of anticipation and obviousness over the prior art. If Boucher

5 needs to cite additional reference(s) in combination with the base reference to

6 support of the obviousness assertion against any claim, a prior conference call with

7 the judge is required.

8   2.   Boucher is not authorized to file a substantive motion against claims

9 1-9 of Connery on the ground that they lack an enabling disclosure. The

10 discussions engaged during the conference call do not indicate sufficient grounds

11 for authorizing this motion, as counsel was unable to articulate a credible reason

12 why one with ordinary skill in the art, if given the claim as instructions on what to

13 build, would not have known how to make and use the claimed invention without

14 undue experimentation. The key question here is not whether the claimed subject

15 matter makes sense or works well but whether one with ordinary skill in the art can

16 make and use it as claimed.

17   This interference is being re-declared in a concurrent paper to eliminate

18 Count 3 and designate the claims which corresponded to Count 3 as corresponding

19 to Count 1.

20   3.   Boucher is authorized to file a substantive motion to redefine the

21 count by substituting new Count 4, defined as the alternative union of present

22 Counts 1 and 2, as the sole count in this interference, and to designate all involved

23 claims of each party as corresponding to new Count 4.

1   4.   Boucher is authorized to file a substantive motion to designate

2   Connery's claims 10-20 as corresponding to either Count 1 or Count 2, or Count 4

3   in the event Count 4 is substituted in for Counts 1 and 2.

4   5.   Boucher is authorized to file a contingent motion, the contingency

5   being the designation of any of Connery's claims 10-20 as corresponding to a

6   count in this interference, alleging unpatentability of Connery's claims 10-20 on

7   the ground of either anticipation or obviousness based on Boucher's Provisional

8   Application 60/061,809, but may initiate a conference call to request changing the

9   base reference to Boucher's Patent 6,226,680. Each claim, however, shall not be

10   subject to both a charge of anticipation and obviousness over the prior art. If

11   Boucher needs to cite additional reference(s) in combination with the base

12   reference to support of the obviousness assertion against any claim, a prior

13   conference call with the judge is required.

14   6.   Boucher is not authorized to file a motion alleging Connery's claims

15   10-20 are without an enabling disclosure, for the same reasons Boucher is not

16   authorized to file a motion alleging Connery's claims 1-9 are without an enabling

17   disclosure.

18   7.   Boucher is not authorized to file a motion to designate claims 1-20 of

19   Connery's Patent 6,956,853, as corresponding to any count in this interference,

20   because Patent 6,956,853 will not be added to this interference.

21   8.   Boucher is not authorized to file a motion to attack the patentability of

22   claims 1-20 of Connery's Patent 6,956,853 over prior art because Patent 6,956,853

23   will not be added tot his interference.

1   9.   Boucher is not authorized to file a motion alleging claims 1-20 of

2   Connery's Patent 6,956,853 are without an enabling disclosure, for the same

3   reasons Boucher is not authorized to file a motion alleging claims 1-9 of Connery's

4   involved patent are without an enabling disclosure.

5   10.   Boucher is authorized to file a motion alleging that claims 1-9 of

6   Connery's involved patents are unpatentable for obviousness type double patenting

7   over one claim of Connery's Patent 6,956,853. The one claim of the Connery

8   Patent 6,956,853 may be different for each involved claim under attack. However,

9   no more than one base claim from Connery's Patent 6,956,853 shall be used in

10   establishing unpatentability of any of Connery's involved claim for obviousness-

11   type double patenting.

12   11.   Boucher is not authorized to attack claims 1-20 of Connery's Patent

13   6,956,853, for obviousness-type double patenting over claims 1-9 of Connery's

14   involved patent because that patent will not be added to this interference.

15   12.   Boucher is authorized to file a contingent motion, if claims 10-20 of

16   Connery's involved patent are designated as corresponding to any count in this

17   interference, to attack them on the ground of obviousness-type double patenting

18   over one claim of Connery's Patent 6,956,853. The one claim of the Connery

19   Patent 6,956,853 may be different for each involved claim under attack. However,

20   no more than one base claim from Connery's Patent 6,956,853 shall be used in

21   establishing unpatentability of any of Connery's involved claim for obviousness-

22   type double patenting.

1   13.   Boucher is not authorized to attack claims 1-20 of Connery's Patent

2   6,956,853, for obviousness-type double patenting over claims 1-20 of Connery's

3   involved patent because that patent will not be added to this interference.

4   14.   Boucher is authorized to file a motion to correct inventorship, to

5   eliminate currently-named inventors Boucher, Blightman, and Starr, and must

6   produce each originally named inventor for deposition, either on cross-examination

7   in connection with declaration testimony in support of the motion or for direct

8   deposition if the inventor is not submitting a declaration in support of the motion.

9   15.   Boucher is authorized to file a priority motion by the filing of the

10   priority motion will be deferred until further notice from the Board.

11   Although Connery's Patent 6,956,853, will not be added to this interference,

12   the patent judge proposed and counsel to both parties have agreed, that in the event

13   that judgment on priority is entered against Connery on any count in this

14   interference, (1) another interference will be declared very soon after entry of

15   judgment, between Boucher's involved application and Connery's Patent

16   6,956,853; (2) the count(s) lost by Connery in this interference will be made the

17   count(s) in the new interference; (3) there will be no priority contest in the new

18   interference as judgment will be entered against Connery on the basis of the

19   judgment reached in this interference; and (4) the only substantive motions to be

20   filed in the subsequent interference will be two -- one by Boucher to designate

21   more claims of Connery as corresponding to the count and one by Connery to

22   designate some claims as not corresponding to the count.

1   B.   Connery's Proposed Motions List

2   1.   Item 1 is moot because this interference is being re-declared to

3   eliminate Count 3.

4   2.   Item 2 is moot because this interference is being re-declared and the

5   re-declaration will make the requested correction.

6   3.   Item 3 is moot because this interference is being re-declared to

7   eliminate Count 3.

8   4.   Connery is authorized to file a priority motion but the actual filing of

9   the motion will be deferred until further notice from the Board.

10   5.   Connery is authorized to file a motion alleging no interference-in-fact.

11   However, the motion shall not reproduce any attack on Boucher's claims for lack

12   of written description. A simple reference to the effect that such an attack is the

13   subject of another motion will suffice. The motion shall focus on Connery's view

14   that no Boucher claim defines the same patentable invention as any Connery claim.

15   6.   Item 6 on Connery's list is not authorized, because much of the delay

16   occurred while the clock was not running on Boucher but while Bouncher was

17   waiting for action from the USPTO and because there was no indication of

18   allowable subject matter until sometime in 2010. Counsel for Connery also

19   indicated that Connery does not take the position that Boucher intentionally

20   delayed prosecution in any way. An interference could not have been declared

21   until an application is in condition for allowance but for the declaration of

22   interference.

1   7.   With respect to the term "transmit control block," Connery is

2   authorized to file a motion alleging unpatentability of Boucher's involved claims

3   for lack of written description but not authorized to file a motion alleging

4   unpatentability of the same claims for lack of an enabling disclosure. The

5   explanation was inadequate why one with ordinary skill in the art would not have

6   know, without undue experimentation, how to make and use the claimed invention.

7   8.   With respect to the phrase "notifying the network interface of an

8   allocated target buffer," Connery is authorized to file a motion alleging

9   unpatentability of Boucher's involved claims for lack of written description but not

10   authorized to file a motion alleging unpatentability of the same claims for lack of

11   an enabling disclosure. The explanation was inadequate why one with ordinary

12   skill in the art would not have know, without undue experimentation, how to make

13   and use the claimed invention. **Items 7 and 8 shall be merged in a single motion**.

14   9.   Item 9, motion to attack benefit to Provisional Application

15   60/061,809, is authorized but the alleged basis is limited to lack of written

16   description for an embodiment falling within the count the priority with respect to

17   which is being challenged.

18   10.   Item 10, motion to attack benefit to Application 09/067,544, is

19   authorized but the alleged basis is limited to lack of written description for an

20   embodiment falling within the count the priority with respect to which is being

21   challenged. **Items 9 and 10 shall be merged in a single motion**.

22   11.   Item 11 is moot because the interference is being re-declared to

23   eliminate Count 3.

12.   Items 12-14 are dismissed as unnecessary. If Count 1 and Count 2 remain in this interference and priority determination is split with respect to the two counts, a telephone conference will be conducted to discuss whether some claims should be re-designated due to operation of law.

13.   See ¶ 12.

14.   See ¶ 12.

15.   Item 15 is dismissed as moot because this interference is being re-declared to eliminate Count 3.

16.   Item 16 is dismissed as moot because this interference is being re-declared to designate Boucher claims 45-47 and Connery claims 5-7 as corresponding to Count 1.

17.   Item 17 is denied because it amounts to the declaration of a patent versus patent interference, with respect to which the Board is without jurisdiction.

/JAMESON LEE/
Administrative Patent Judge

1   By Electronic Transmission:

2   Attorney for Junior Party Connery:

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

GLENN W. **CONNERY**, GARY JASZEWSKI and RICHARD REID
Junior Party
(Patent 6,246,683)

v.

LAURENCE B. **BOUCHER**, STEPHEN E. BLIGHTMAN, PETER K. CRAFT,
DAVID A. HIGGEN, CLIVE M. PHILBRICK and
DARYL D. STARR
Senior Party
(Application 09/692,561)

_____

Patent Interference No. 105,775 (JL)
(Technology Center 2400)

_____

Before JAMESON LEE, RICHARD TORCZON, and JONI Y. CHANG,
Administrative Patent Judges.

PER CURIAM.

DECISION -- MOTIONS -- BD. R. 125(a)

1   **Introduction**

2   This interference was declared on September 14, 2010, with Count 1,

3   Count 2, and Count 3. Pending before us are Connery Substantive Motions 1-3

1   and Motion 5 to exclude evidence, and Boucher's Substantive Motions 1-5 and

2   Motion 6 to exclude evidence.

3   Connery's real party in interest is Hewlett-Packard Company, and Boucher's

4   real party in interest is Alacritech, Inc.

5   Connery's Motion 1 alleges that there is no interference-in-fact. Connery's

6   Motion 2 asserts that all of Boucher's claims are unpatentable for lack of written

7   description in the specification. Connery's Motion 3 seeks to deny the benefit

8   initially accorded Boucher in the Notice Declaring Interference.

9   Boucher's Motion 1 asserts that Connery's claims 1-9 are unpatentable over

10   prior art under 35 U.S.C. § 102 for anticipation. Boucher's Motion 2 seeks to

11   substitute a single Count 4 for existing Counts 1 and 2. Boucher's Motion 3 seeks

12   to designate Connery's claims 10-20 as corresponding to the count. Boucher's

13   Motion 4 asserts that Connery's claims 10-20 are unpatentable over prior art under

14   35 U.S.C. § 102 for anticipation. Boucher's Motion 5 seeks to amend the named

15   inventorship of Boucher's involved application, to delete Laurence B. Boucher,

16   Stephen E. Blightman, and Daryl D. Starr as co-inventors.

17   **Analysis**

18   A.   Connery's Motion 1
19   Asserting No Interference-In-Fact

20   Connery as the party movant bears the burden of proof to demonstrate

21   entitlement to the relief requested. 37 C.F.R. § 41.121(b). The applicable burden

22   of proof is that by a preponderance of the evidence. *Bosies v. Benedict*, 27 F.3d

23   539, 541-42 (Fed. Cir. 1994).

1   An interference-in-fact exists if the subject matter of a claim of one party

2   would, if prior art, have anticipated or rendered obvious the subject matter of a

3   claim of the opposing party and vice versa. 37 C.F.R. § 41.203(a). That means

4   interference-in-fact requires at least two-way anticipation or obviousness between

5   one claim from one party and one claim from an opposing party. *See, e.g., Eli Lilly*

6   *& Co. v. Bd. of Regents of the Univ. of Wash.*, 334 F.3d 1264, 1267 (Fed. Cir.

7   2003); *Winter v. Fujita*, 53 USPQ2d 1234, 1243 (Bd. Pat. App. & Int. 1999).

8   Because two-way anticipation/obviousness is required for there to be an

9   interference-in-fact, Connery correctly states that as the party asserting no

10 interference-in-fact it need only demonstrate one-way novelty and non-obvious

11 between its involved claims and Boucher's involved claims. *See Noelle v.*

12 *Lederman*, 355 F.3d 1343, 1351 (Fed. Cir. 2004). However, the analysis must

13 account for every claim of each party. In other words, Connery must demonstrate

14 either (1) that none of Connery's involved claims anticipates or renders obvious

15 any of Boucher's involved claims, or (2) that none of Boucher's involved claims

16 anticipates or renders obvious any of Connery's involved claims. Connery has

17 elected to demonstrate the latter. (Motion 5:11-13).

18   Boucher's involved claims are claims 41-49.

19   Connery's involved claims are claims 1-9.

20   Boucher's claims 41-49 are copied, respectively, from Connery's claims 1-9,

21 except essentially for one term-change. Boucher's claim 41 and Connery's claim 1

22 are the only independent claims and are reproduced below, side-by-side, in a table,

23 with the difference in claim term bolded for emphasis. Other Connery claims

24 depend from claim 1 and other Boucher claims depend from claim 41.

1

Claim Chart

Boucher Claim 41:	Connery Claim 1:
41. A method for transferring data on a network from a data source to an end station executing a multi-layer network protocol, including a network layer and at least one higher layer, through a network interface on the end station, comprising:	1. A method for transferring data on a network from a data source to an end station executing a multi-layer network protocol, including a network layer and at least one higher layer, through a network interface on the end station, comprising:
receiving in the network interface a packet which carries a data payload from a block of data in the data source, and a control field identifying the packet;	receiving in the network interface a packet which carries a data payload from a block of data in the data source, and a control field identifying the packet;
determining based on the control field in the network interface whether the packet matches a **transmit control block (TCB),** and if so transferring the data payload in the packet directly to a target buffer assigned by a process at a layer higher than the network layer.	determining based on the control field in the network interface whether the packet matches a **flow specification,** and if so transferring the data payload in the packet directly to a target buffer assigned by a process at a layer higher than the network layer.

1   A finding of anticipation requires that each and every element, arranged in a

2   combination precisely as is recited in the claim, must be found in a single prior art

3   reference. *Karsten Manufacturing Corp. v. Cleveland Golf Co.*, 242 F.3d 1376,

4   1383 (Fed. Cir. 2001). However, in the context of a no interference-in-fact

5   analysis, the applied prior art is each claim of one party, rather than the entire

6   specification. *See Noelle v. Lederman*, 355 F.3d at 1352.

7   Connery must show that none of Boucher's claims 41-49 anticipates any of

8   Connery's claims 1-9. Connery may do so by showing that Boucher claim 41 does

9   not anticipate Connery claim 1, because a dependent claim includes all the

10   limitations of the claim on which it depends. Boucher claims 42-49 each include

11   all the features of Boucher claim 41 and Connery claims 2-9 each include all the

12   features of Connery claim 1.

13   As is evident from the above claim chart, Boucher's claim 41 anticipates

14   Connery's claim 1 if and only if Boucher's claim term "transfer control block"

15   reads on Connery's claim term "flow specification." Thus, Boucher's claim 41

16   anticipates Connery's claim 1 if and only if Boucher's "transfer control block"

17   qualifies as a "flow specification" in the context of Connery's specification.

18   According to Connery, at the relevant time of the parties' invention, the term

19   "transfer control block" or "TCB" was an established technical term of art with a

20   well-recognized meaning to one with ordinary skill. Through the declaration of its

21   technical witness David B. Johnson (Exhibit 2004, ¶ 45), Connery cites to pages 11

22   and 19 of RFC793, "Transmission Control Protocol: DARPA Internet Program

23   Protocol Specification" (September 1981), which is submitted by Connery as

24   Exhibit 2011 and by Boucher as Exhibit 1006. Connery states (Motion 2:17-19)

1   that TCB was a standardized data structure used to define the present state of a

2   standard TCP/IP connection between the host as the data destination and the data

3   source furnishing the data. However, aside from discussing the particular

4   implementation of a TCB described in the context of Boucher's Provisional

5   Application 60/061,809, which has been incorporated by reference into Boucher's

6   involved application disclosure, Connery does not expressly articulate the

7   minimum requirements, independent of Boucher's own specific implementation,

8   generally recognized by one with ordinary skill in the art of what must be

9   contained in a Transfer Control Block or TCB. Connery states just that the TCB

10 data structure keeps track of all the information required for handling a TCP/IP

11 connection and that the TCB is essentially a snapshot of the current state or context

12 of the TCP/IP connection that is updated with every packet. (Motion 8:24-27).

13   We look to the cited portion of RFC793 (Ex. 2011 at 11 and 19) and

14 reproduce this pertinent text:

15   [at 11] There are several things that must be remembered about a
16   connection. To store this information we imagine that there is a data
17   structure called a Transmission Control Block (TCB).
18
19   [at 19] Before we can discuss very much about the operation of the
20   TCP we need to introduce some detailed terminology. The
21   maintenance of a TCP connection requires the remembering of several
22   variables. We conceive of these variables being stored in a
23   connection record called a Transmission Control Block or TCB.
24   Among the variables stored in the TCB are the local and remote
25   socket numbers, the security and precedence of the connection,
26   pointers to the user's send and receive buffers, pointers to the
27   retransmit queue and to the current segment. In addition several

1   variables relating to the send and receive sequence numbers are stored
2   in the TCB.
3
4   Boucher, on the other hand, indicates that the protocol standard represented

5   by RFC793 (Exhibit 1006 or Exhibit 2011) defines the notion of a TCB and

6   suggests some of the contents, but notes that the implementation of a TCB can vary

7   and so there really is not a "standard TCB." Boucher's technical witness Tal

8   Lavian testifies that the protocol standard set forth in RFC793 for a TCB suggests

9   some contents but the specific implementation varies from case to case. (Exhibit

10 1051, ¶¶ 26, 28). Connery points to no contrary testimony of its witness David B.

11 Johnson. In that regard, Boucher also cites to Comer and Stevens,

12 "Internetworking with TCP/IP." Vol. II, p. 166 (1991) (Exhibit 2010). The

13 pertinent portion of Exhibit 2010 at 166, is reproduced below:

14   TCP coordinates the activities of transmission, reception, and
15   retransmission for each TCP connection through a data structure
16   shared by all processes. The data structure is known as a *transmission*
17   *control block* or TCB. TCP maintains one TCB for each active
18   connection. **The TCB contains all information about the TCP**
19   **connection,** including the addresses and port numbers of the
20   connection endpoints, the current round-trip time estimate, data that
21   has been sent or received, whether acknowledgment or retransmission
22   is needed, **and any statistics TCP gathers about the use of the**
23   **connection.**
24
25   Although the protocol standard defines the notion of the TCB
26   and suggests some of the contents, it does not dictate all the details.
27   Thus, **a designer must choose the exact contents.** (Emphasis
28   added.)
29

1   Boucher admits (Opp. 36:18-22) that a TCB was known to be a data

2   structure that holds information for a TCP connection, and also represents that the

3   terms "TCB," "TCB connection," and "connection context" were used

4   interchangeably in the disclosure of the Boucher provisional application which has

5   been incorporated by reference into Boucher's involved application.

6   On this record, Connery establishes only that the claim term "transfer

7   control block" in Boucher's claim 41, otherwise known as "TCB," was at the

8   relevant time of the parties' invention a term of art having the general meaning of a

9   data structure used to hold or store useful information about the status and use of a

10   TCP connection. Connery has not shown that any particular or specific

11   information is always required to be stored in a transfer control block TCB data

12   structure. As is represented by Boucher, the specific implementation can vary

13   among embodiments. As is indicated in the above-quoted text from Comer and

14   Stevens (Exhibit 2010), the designer of the TCB data structure must choose its

15   exact contents.

16   With regard to Connery's claim term "flow specification," however, the

17   parties do not dispute that it is not an established or well recognized technical term

18   of art with a fixed meaning from the perspective of one with ordinary skill. We

19   must look to Connery's specification to construe the meaning of "flow

20   specification" from the perspective of one with ordinary skill in the art. Connery's

21   disclosed invention is a method for transferring data on a network from the data

22   source to an application executing in an end station. (Exhibit 2009, 2:17-19). The

23   following text in Connery's Summary of the Invention conveys much about

1   Connery's invention and is especially indicative of the intended meaning for the

2   term "flow specification" in Connery's disclosure (Exhibit 2009, 2:32-45):

3   Typically, to initiate the process of receiving a plurality of
4   packets which make up a block of data for a particular application, the
5   process involves establishing a connection between the end station
6   and the source of data, such as a file server on a network, for example
7   according to the TCP/IP protocol suite. A request is transmitted from
8   the application through the network interface which asks for transfer
9   of the data from the data source. The request and the protocol suite
10   **provide a flow specification to identify the block of data** and an
11   identifier of the target buffer. At the network interface, the plurality
12   of packets is received, and their control fields, such as TCP/IP
13   headers, are read. If they fall within the set up flow specification, the
14   payloads are bypassed directly into the target buffer. (Emphasis
15   added.)
16
17 Thus, "flow specification" broadly refers to information which identifies a

18 block of data being or to be transferred from a data source.

19   The following text from Connery's specification (Exhibit 2009, 2:48-56)

20 indicates that in a "preferred" embodiment the flow specification includes a range

21 of sequence numbers for the block of data, such as a starting number and a length

22 number:

23   Also, according to a **preferred aspect of the invention**, the packets
24   carrying data payload for the block of data include a sequence number
25   or other identifier by which the network interface is able to determine
26   the offset within the target buffer to which the payload of the packet is
27   to be stored. **In this case, the flow specification includes a range of**
28   **sequence numbers for the block of data,** such as by a starting
29   number and a length number. (Emphasis added.)
30

1   It is only in the case that each data packet includes a sequence number that the

2   flow specification would include a specific range of sequence numbers to identify

3   the block of interested data, such as a starting sequence number and a length

4   number. Further description in Connery's specification (Exhibit 2009, 5:18-19)

5   confirms that "flow specification" is a general construct and covers whatever that

6   can be used to specifically identify a block of interested data: "The flow

7   specification specifies how to identify packets that are part of this session."

8   In the preferred embodiment disclosed by Connery, the flow specification

9   also includes the source and destination IP addresses, source and destination port

10 or socket numbers, a SEQorigin and an SMBfirst flag. (Exhibit 2009, 5:10-14).

11 SEQorigin specifies the sequence number of the first byte of the payload that

12 should be stored in the target buffer. (Exhibit 2009, 5:19-22). None of those items

13 has been described as necessary or required in each flow specification for

14 identifying the block of data to be received and placed directly into a target buffer.

15   For its preferred embodiment, Connery's specification describes that the

16 flow specification for the block of data to be transferred includes, "for example," a

17 sequence number range, socket numbers, and source and destination addresses of

18 packets which will be part of the flow. (Exhibit 2009, 7:21-29). Again, none of

19 those items has been described as necessary or required in each flow specification.

20 In that connection, Connery's specification states (Exhibit 2009, 7:56-59):

21   The foregoing description of a preferred embodiment of the
22   invention has been presented for purposes of illustration and
23   description. It is not intended to be exhaustive or to limit the
24   invention to the precise forms disclosed.

1   Accordingly, we interpret "flow specification" in the context of Connery's

2 specification as broadly covering any information which identifies a block of data

3 for transfer from a data source. While it may include connection information such

4 as port or socket numbers and source and destination addresses of data packets, it

5 must include a single item: information identifying a block of data for transfer.

6   We reject Connery's proposed interpretation of "flow specification" as

7 necessarily also including (3) a sequence number range of the expected packets

8 from the block of data to be transferred, (4) specific memory and payload offset

9 information in addition to information identifying the target buffer, and (5) a

10 requirement that the flow specification be provided to a smart network interface

11 card (SNIC) prior to the arrival of the first data packet belonging to the block of

12 data for transfer. These additional three items merely reflect Connery's specific

13 implementation and use of a flow specification in a preferred embodiment of the

14 claimed invention and are not part and parcel to every single flow specification.

15   We also reject the interpretation urged by Boucher, one that covers only

16 connection information like that of transfer control block and has nothing to do

17 with identification of a block of data. That position fails to account for the clear

18 indication from Connery's specification as discussed above. Boucher's position

19 derives from what one with ordinary skill in the art likely would have thought not

20 knowing the description of invention in Connery's specification. The correct

21 approach to claim interpretation, however, is based on the underlying specification

22 as would be read by one with ordinary skill in the art, not independent of the

23 specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-1317 (Fed. Cir.

24 2005)(in banc)(claim terms are interpreted primarily in light of intrinsic evidence

1   such as the specification); *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983).

2   Here, for reasons already discussed above, construing "flow specification" such

3   that it does not require identification of a block of data for transfer would be

4   inconsistent with Connery's specification.

5   Accordingly, there is a basic distinction between Boucher's "transfer control

6   block" and Connery's "flow specification." While the former is primarily

7   concerned with the state of a network data transfer connection such as IP send and

8   receive addresses and port or socket numbers, the latter is primarily concerned with

9   identification of a particular block of data for transfer from a data source.

10   However, there is room for potential overlap between a transfer control

11   block and a flow specification. A "flow specification" which also includes certain

12   connection information may also constitute or be deemed a "transfer control block"

13   or TCB, and a "transfer control block" or TCB can also qualify as or be deemed a

14   "flow specification" if it also includes information identifying the block of data for

15   transfer from a data source.

16   Because a transfer control block or TCB does not have to include

17   information identifying the block of data for transfer from a data source, the

18   recitation of a transfer control block in Boucher's claim 41 does not read on or

19   satisfy the recitation of a flow specification in Connery's claim 1.

20   Accordingly, Boucher's claim 41 does not anticipate Connery's claim 1 or

21   Connery's claims 2-9 which depend from claim 1. The same is true for Boucher's

22   claims 42-49 which depend from claim 41, none of which add to claim 41 the

23   feature of including in the transfer control block information identifying a block of

24   data for transfer from a data source.

1   Connery also must show that none of Boucher's claims 41-49 renders

2   obvious any of Connery's claims 1-9. Obviousness is a legal determination made

3   on the basis of underlying factual inquiries including (1) the scope and content of

4   the prior art; (2) the differences between the claimed invention and the prior art;

5   (3) the level of ordinary skill in the art; and (4) any objective evidence of

6   unobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). One with

7   ordinary skill in the art is presumed to have skills apart from what the prior art

8   references explicitly say. *In re Sovish*, 769 F.2d 738, 742 (Fed. Cir. 1985). A

9   person of ordinary skill in the art is a person of ordinary creativity, and is not an

10   automaton. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

11   Our review of Connery's Motion 1 reveals that Connery has not adequately

12   accounted for the scope and content of the prior art or correctly determined the

13   differences between the claimed invention and the prior art. On determining the

14   scope and content of the prior art, there are two problems with Connery's

15   approach.

16   First, it is evident that in its Motion 1 Connery is applying Boucher's

17   disclosed preferred embodiment of the transfer control block and how the transfer

18   control block is used in that particular implementation as the prior art rather than

19   applying each Boucher claim as prior art. That improperly enlarges the difference

20   between Boucher's claims and Connery's claims.

21   For instance, Connery states the following, purportedly about Boucher's

22   claimed invention (Motion 2:16 to 3:18):

23   A transmit control block (TCB), as Boucher claims,
24   significantly differs in both content and operation from a flow

1   specification. (MF 16.) At the time of the invention, a TCB was a
2   standardized data structure used to define the present state of a
3   standard TCP/IP connection between the host (the data destination)
4   and the data source. (MF 17.) All Boucher has done is to associate
5   these old TCBs with so-called "fast[-] path processing" (i.e., the
6   storage of a data payload into a target buffer on the host). (MF 18.)
7   In Boucher, after a TCP/IP connection has been established and that
8   connection is deemed to be fast-path connection, the TCB for that
9   connection is sent from the host to the "intelligent" network interface
10   card (INIC), so that TCP/IP processing is done there rather than on the
11   host. (MF 19.) When a packet arrives at the INIC, the connection
12   information in its header is matched against the connection
13   information in the TCB to see whether the packet belongs to a fast-
14   path processing connection. (MF 20.) If the packet meets other non-
15   TCB-based criteria, it will be fast-path processed. (MF 21.)
16
17   Unlike the flow specification, the TCB has no relationship to a
18   specific request for a block of data, for example, it does not contain a
19   sequence number range defining the beginning and end of the block of
20   data. (MF 22.) Rather, the TCB changes with each received packet,
21   and contains the sequence number for the presently received packet –
22   not a range for a block of data. (MF 23.) Because of this, the
23   Boucher method cannot associate the received packet with a block of
24   data for a specific data request and cannot handle out of order packets.
25   (MF 24.)
26
27   In the Boucher method, there is no prior knowledge of the size
28   of the block of data that has been requested and no pre-allocation of
29   target buffer memory. (MF 25.) Unlike the flow specification, the
30   TCB does not contain the memory address and memory and payload
31   offset information that is used to store directly a received packet into a
32   pre-allocated target buffer. (MF 26.) Moreover, before a correctly
33   sized target buffer can be allocated for fast-path processing, one or
34   more packets must be received using conventional slow-path
35   processing so that the host can determine the size of the data transfer.

1   (MF 27.) Consequently, all received packets will not be fast-path
2   processed in the Boucher method. (MF 28.)
3
4   The description of Boucher's method, contained in the above-quoted text, is

5   directed to the preferred embodiment and specific implementation in Boucher's

6   specification and not to features in Boucher's claims. Connery has failed to show

7   what part of that described process implementation, if any, is required by any

8   Boucher claim.

9   The fact that in Boucher's specific process implementation the TCB does not

10 contain the sequence range for the data block to be transferred does not mean

11 Boucher's claims preclude the presence of such a sequence range in all TCBs. The

12 fact that in Boucher's specific process implementation the correct buffer size is not

13 determined until at least some packets from the block of data have already been

14 received does not mean Boucher's claims preclude pre-allocation of a target buffer.

15 The fact that in Boucher's specific process implementation not all received packets

16 from a block of data will be fast-path processed does not mean Boucher's claims

17 preclude fast-path processing of all the data packets from an expected block of

18 data.

19   Connery also states the following, ostensibly about Boucher's claimed

20 invention (Motion 9:3-27):

21   Once the TCP/IP connection is established and stable, and if
22   that connection has been designated by the host processor for fast-path
23   processing, the host processor transfers the TCB for that connection to
24   the INIC, so the INIC can take over the processing for that connection
25   from that point forward (unless an exception occurs, *infra*). (MF 51.)
26   The INIC thus implements the TCP/IP protocol for the fast-path
27   connections. (MF 52.) When receiving data from the network, the

1   INIC unpackages the header information. (MF 53.) If the TCP/IP
2   connection information (i.e., the IP addresses and TCP port numbers
3   for the source and destination computers) of the TCB matches the
4   respective connection information of the packet header, then the
5   packet is matched to that TCP connection. (MF 54). That is the only
6   TCB matching described in the Boucher Provisional. (MF 55.)
7
8   Subsequently, if and only if the information in the packet
9   header satisfies other criteria not determined through this TCB
10   matching (such as no fragmentation; packet received in order; no
11   exceptions) and a target buffer on the host processor memory has been
12   assigned by the host processor, the payload data will be copied to the
13   target buffer – the fast-path processing. (MF 56.) This avoids the
14   multiple copying of the packet data by the host processor. (MF 57.)
15   Notably, the target processor is not assigned in the Boucher process
16   until a small amount of data has been received and conventionally
17   slow-path processed by the host processor, which permits the host
18   processor to establish the TCP/IP connection and determine [how]
19   large the target buffer should be. (MF 58.) This means, unlike the
20   Connery invention, all received packets associated with a given data
21   request cannot be fast-path processed. (MF 59.) Also, if during the
22   handling of a TCP/IP connection any condition arises that cannot be
23   handled by the INIC, such as the receipt of an out of order packet, the
24   INIC passes the TCB for that connection back to the host processor,
25   after which the packets are conventionally (slow-path) processed
26   through the host's TCP/IP stack. (MF 60.)
27
28   Again, the description of Boucher's method, contained in the above-quoted

29   text, is directed to the preferred embodiment and specific implementation in

30   Boucher's specification and not to features in Boucher's claims. Connery has

31   failed to show what part of that described process implementation, if any, is

32   required by any Boucher claim.

1   Secondly, we recognize that unlike the case of having to show obviousness,

2   which begins with knowledge of the entirety of the applied prior art, Connery's

3   showing of nonobviousness requires proof of a negative and cannot possibly

4   account for the entire knowledge base of potentially applicable prior art. However,

5   Connery must at least reveal and present what it knows about the features present

6   in Connery's claims but absent in Boucher's claims. That has not happened here.

7   What is different in Boucher's claims as prior art, as compared to Connery's

8   claims, as already noted above, is the inclusion in Boucher's transfer control block

9   or TCB information identifying the block of data being transferred or to be

10   transferred. In that regard, Connery presents nothing about what it knows about

11   pre-existing use of such information in the context of network data transfer.

12   Connery cannot properly limit its discussion to just what is specified in Boucher's

13   claims. Many pertinent questions remain unaddressed. For instance, to Connery's

14   knowledge, has information identifying the block of data being transferred or to be

15   transferred from a data source ever been stored within the same data structure that

16   holds information about the network connection, and if so, in what context?

17   Having not revealed and discussed such information, Connery has failed to fully

18   address the applicable scope and content of the prior art.

19   As for Connery's not having correctly determined the difference between the

20   claimed invention and the prior art, note our discussion above on how Connery

21   mistakenly treats Boucher's disclosed preferred embodiment and specific

22   implementation as prior art rather than each Boucher claim. Also note our

23   discussion above on how Connery mistakenly interpreted the scope of its own

24   claims more narrowly than it should. The natural consequence of such acts is the

1   incorrect determination of the differences between the parties' claims. To the

2   extent that Connery believes its claims require that all data packets from the same

3   block of data for transfer, without exception, be directly placed in a target buffer

4   (Motion 9:21-23), that is incorrect. Connery has failed to explain where such a

5   requirement exists in its claims and we do not see any such requirement in its

6   claims.

7   For all of the foregoing reasons, Connery has not met its burden of proof in

8   demonstrating that none of Boucher's claims 41-49 renders obvious any of

9   Connery's claims 1-9. Accordingly, Connery's Motion 1 is **denied**.

10   B.   Connery's Motion 2
11   Asserting Lack of Written Description

12   Pursuant to 37 C.F.R. § 121(a)(1)(iii), Connery moves for judgment against

13   Boucher on the basis that Boucher's involved claims 41-49 are unpatentable under

14   35 U.S.C. § 112, first paragraph, for lack of written description. To be sufficient, a

15   motion must provide a showing, supported with appropriate evidence, such that, if

16   unrebutted, it would justify the relief sought. 37 C.F.R. § 208(b). As the moving

17   party, Connery has the burden of proof by a preponderance of the evidence. 37

18   C.F.R. § 121(b); *see also Bosies v. Benedict*, 27 F.2d 539, 541-42 (Fed. Cir. 1994).

19

1 The test for determining compliance with the written description

2 requirement under 35 U.S.C. § 112, first paragraph, is "whether the disclosure of

3 the application as originally filed reasonably conveys to the artisan that the

4 inventor had possession at that time of the later claimed subject matter." *In re*

5 *Kaslow.* 707 F.2d 1366, 1375 (Fed. Cir. 1983). This test requires an "objective

6 inquiry into the four corners of the specification from the perspective of a person

7 of ordinary skill in the art." *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336,

8 1351 (Fed. Cir. 2010) (en banc). Because the specification is viewed from the

9 perspective of one of skill, the level of detail required "varies with the nature and

10 scope of the invention at issue, and with the scientific and technologic knowledge

11 already in existence." *Capon v. Eshhar*, 418 F.3d 1349, 1357 (Fed. Cir. 2005); *see*

12 *also Ariad,* 598 F.3d at 1351.

13 For reasons articulate below, Connery's Motion 2 is <u>granted</u> as to claims 46-

14 49, but <u>denied</u> as to claims 41-45.

15   Boucher's Claims

16 Boucher's claims 41-49 are reproduced as follows (Paper 6 at 2-4, emphasis

17 added to highlight the disputed limitations):

18   41. A method for transferring data on a network from a data source
19   to an end station executing a multi-layer network protocol,
20   including a network layer and at least one higher layer, through a
21   network interface on the end station, comprising:

22   receiving in the network interface a packet which carries a
23   data payload from a block of data in the data source, and a control
24   field identifying the packet;

1   *determining based on the control field in the network*
2   *interface whether the packet matches a transmit control block*
3   *(TCB), and if so* transferring the data payload in the packet directly
4   to a target buffer assigned by a process at a layer higher than the
5   network layer.

6   42. The method of claim 41, wherein the control field in the packet
7   includes a packet header.

8   43. The method of claim 41, wherein the multi-layer network protocol
9   comprises TCP/IP, and the control field comprises a TCP/IP header.

10   44. The method of claim 41, including *prior to receiving the packet,*
11   *allocating the target buffer for a plurality of packets*, and notifying
12   the network interface of the allocated target buffer.

13   45. The method of claim 41, wherein the network interface is
14   coupled to a network medium supporting a maximum packet size,
15   and including transmitting a request from an application for transfer
16   of a block of data from the data source, the block of data having a
17   length greater than the maximum packet size for the medium.

18   46. The method of claim 45, including *notifying the network*
19   *interface in response to the request of the TCB for the block of data*
20   according to the multi-layer network protocol, and wherein the step
21   of receiving the packet includes identifying packet using the TCB.

22   47. The method of claim 46, wherein the network protocol
23   comprises TCP/IP, and *the TCB includes a sequence number of a*
24   *first byte from a plurality of packets to be stored in the target*
25   *buffer.*

26   48. The method of claim 41, wherein *the TCB includes a sequence*
27   *number for the block of data.*

1   49. The method of claim 48, wherein the TCB includes IP source

2   and destination addresses and TCP port numbers.

3   Discussion

4   *Boucher's Claim 41*

5   Connery argues that in the context of the Connery's patent, and especially in

6   view of the words "and if so," the last limitation of Boucher's claim 41 requires the

7   following additional items: (1) "*all* matching must be accomplished, by

8   comparison of the packet to the TCB, *before* any data payloads are transferred into

9   the target buffer," and (2) the determining step further requires "determining if the

10   packet is carrying a data payload for the block of data." (Connery Motion 2 at 8-

11   10, emphasis in original.) Based on this construction of Boucher's claim 41,

12   Connery contends that Boucher's application fails to support the claim because it

13   does not describe these additional items. (*Id.* at 9-10.)

14   At the outset, we disagree with Connery that the contested limitation (*i.e.,*

15   the last limitation of Boucher's claim 41) should be interpreted in the context of

16   Connery's patent.

17   We recognize the precedent that when a party challenges written description

18   support for an application claim copied from a patent, the originating disclosure of

19   the patent provides the meaning of the copied claim language. *See Agilent Tech.,*

20   *Inc. v. Affymetrix, Inc.,* 567 F.3d 1366, 1374-75 (Fed. Cir. 2009); *Koninklijke*

21   *Philips Elecs. N.V. v. Cardiac Sci. Operating Co.,* 590 F.3d 1326, 1335 (Fed. Cir.

22   2010). It is not clear how the precedent applies when a claim is only partially

23   copied, as is the case here. Boucher replaced Connery's term "flow specification"

1 with the term "transmit control block" or "TCB."

2   Further, the principal issues raised by Connery in this motion are related to

3 the non-copied term "transmit control block" or "TCB" and the method steps or

4 operations involving the non-copied term. For instance, the contested claim

5 limitation that Connery is interpreting to require the additional items expressly

6 recites the non-copied term "transmit control block." Moreover, Connery's patent

7 does not use the claim term "transmit control block" or "TCB," but rather the term

8 "flow specification." As such, the contested claim limitation that contains the non-

9 copied term "transmit control block" or "TCB" and method steps involving the

10 non-copied term (including operations applied to the object defined by the non-

11 copied term) should be interpreted in light of Boucher's own specification.

12   In this regard, the claim limitation must be given its broadest reasonable

13 construction consistent with Boucher's specification as it would be interpreted by

14 one of ordinary skill in the art. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed

15 Cir. 2005) (en banc); *Yorkey v. Diab*, 605 F.3d 1297, 1300-01 (Fed. Cir. 2010).

16 And, a particular embodiment appearing in the written description should not be

17 read into the claim if the claim language is broader than the embodiment. *In re*

18 *Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

19   While Connery recognizes that the non-copied term "TCB" is governed by

20 the Boucher's application, Connery nevertheless construes the contested claim

21 limitation in the context of Connery's patent using Connery's term "flow

22 specification" in place of Boucher's non-copied claim term "TCB." (Connery

23 Motion 2 at 8-9.) For example, to support its argument that Boucher's claim 41

24 requires the additional items, Connery asserts that "[t]his is exactly how the

1   claimed Connery method works when using a **flow specification** – once the packet

2   header data matches the **flow specification** parameters, the packet's data payload

3   is transferred directly to the pre-allocated target buffer." (*Id.* at 8-9, emphasis

4   added.)

5   We do not find Connery's claim construction reasonable because there is a

6   basic distinction between Boucher's "TCB" and Connery's "flow specification."

7   As discussed previously in our analysis for Connery's Motion 1, the term "TCB" is

8   a term of art having the general meaning of a data structure used to hold or store

9   useful information about the status and use of a TCP connection. On the other

10   hand, Connery's term "flow specification" does not have an art-recognized

11   meaning, but rather it has a unique meaning as used in Connery's patent.

12   Even if we were to interpret the contested limitation in the light of

13   Connery's patent, Boucher's claim would not require the additional items. In our

14   analysis for Connery's Motion 1, we interpret "flow specification" in the context of

15   Connery's patent as covering any information which identifies a block of data for

16   transfer from a data source. And, we have rejected the additional items that reflect

17   Connery's specific implementation and use of a flow specification in a preferred

18   embodiment.

19   Accordingly, we do not agree with Connery's construction that the contested

20   limitation requires the additional items. *Phillips*, 415 F.3d at 1323 ("expressly

21   rejected the contention that if a patent describes only a single embodiment, the

22   claims of the patent must be construed as being limited to that embodiment.").

23   To support its motion, Connery has submitted the declaration of its technical

24   witness David B. Johnson. (Connery Motion 2 at A2-6 to A2-14; Exhibit 2004

1   ¶¶ 146-154.) While we have considered Johnson's declaration, we give Johnson's

2   testimony little weight because: (1) Johnson has erroneously made the assumption

3   that Boucher's entire claim was copied from Connery's patent; (2) Johnson has

4   interpreted Boucher's non-copied term "TCB" in light of Connery's patent, using

5   Connery's term "flow specification" in place of Boucher's term "TCB"; and (3)

6   Johnson has improperly imported limitations from Connery's patent into Boucher's

7   claim. For instance, Johnson declares the following (Exhibit 2004 ¶¶ 146, 148, and

8   150, bracketed matter and emphasis added):

9   146.   In the context of written description, I have been advised
10   that if **claim terms or features have been copied identically** by one
11   party, then those claim terms or features are defined in view of the
12   other party's specification from which they were copied.

13   148.   In my opinion, that phrase, **in the context of the
14   Connery application**, and especially the words "and if so" in the
15   claim, requires the performance of *all* matching to be accomplished
16   by comparison to the TCB before any data payloads may be
17   transferred into the target buffer to occur. [**Referencing Connery's
18   patent, col. 7:36-39.**]

19   150.   In additional, in my opinion, the phrase "determining …
20   whether the packet matches" when construed **in light of the Connery
21   Patent** further requires "determining if the packet is carrying a data
22   payload for the block of data." **According to the specification of the
23   Connery Patent**, "[i]n the network adapter the bypass is set up by
24   storing a **flow specification** for the block of data that will be subject
25   of the read bypass." [**Referencing Connery's patent, col. 7:23-25.**]
26   The request for a block of data and the protocol suite on the host
27   "provide a **flow specification** to identify the block of data."
28   [**Referencing Connery's patent, col. 2:39-40**] To apply the read
29   bypass, in the SNIC, incoming packets "are identified by the network
30   interface card as part of the response" to the request for the block of

1   data using the "**flow specification**." [*Id.* col. 6:51-52] The payloads
2   for "the packets carrying data payload for the block of data" are
3   directly copied to pre-assigned buffers in the host memory. [*Id.* col.
4   2:41-56.]

5 Clearly, Johnson also fails to consider Boucher's specification and apply the

6 broadest reasonable construction as it would be interpreted by one of ordinary skill

7 in the art.

8   Based on the improper claim construction, Connery argues that Boucher's

9 application fails to provide support for the contested limitation. For instance,

10 Connery contents that Boucher's "TCB only determines whether a received packet

11 belongs to a fast-path connection – further other criteria must be met before the

12 packet's data payload is transferred to the target buffer, and that other criteria does

13 not involve the TCB matching." (Connery Motion 2 at 9-10.) Connery also

14 contends that Boucher does not describe "any TCB that, upon matching,

15 determines if the packet is responsive to a request for a given block of data." *Id.*

16   We do not find those arguments persuasive. Connery has not directed us to

17 where Boucher's specification expressly defines the term "and if so" or any other

18 claim term to preclude additional checking steps. *See In re Paulsen*, 30 F.3d 1475,

19 1480 (Fed. Cir. 1994) ("Although an inventor is indeed free to define the specific

20 terms used to describe his or her invention, this must be done with reasonable

21 clarity, deliberateness, and precision. 'Where an inventor chooses to be his own

22 lexicographer and to give terms uncommon meanings, he must set out his

23 uncommon definition in some manner within the patent disclosure' so as to give

24 one of ordinary skill in the art notice of the change.") (citation omitted).

1   In the absence of an express definition, a claim term has the meaning as it

2   would have to a person of ordinary skill in the art at the time of the invention,

3   consistent with Boucher's specification. Indeed, the claim uses the transitional

4   phrase "comprising" that does not preclude additional method steps. Moreover,

5   there is no claim language that requires the data payload be sent to a target buffer

6   immediately without other activities after the TCB matching step. Accordingly,

7   Boucher's claim 41 does not preclude other checking steps, and does not require

8   "all matching must be accomplished by comparison of the packet to the TCB."

9   Similarly, Boucher's claim 41 does not require the TCB matching step to

10   "determin[e] if the packet is carrying a data payload for the block of data."

11   Connery has not directed us to the claim language that expressly requires such

12   limitation or where Boucher's specification provides a definition of a claim term

13   that requires such limitation.

14   For the foregoing reasons, Connery has failed to sufficiently demonstrate

15   that Boucher's claim 41 is unpatentable under 35 U.S.C. § 112, first paragraph, for

16   lack of written description.

17   *Boucher's Claims 42-43 and 45*

18   Connery does not separately argue dependent claims 42-43 and 45.

19   (Connery Motion 2 at 10-11.) These claims stand or fall with Boucher's

20   independent claim 41. Based on the reasons stated previously with respect to

21   independent claim 41, we likewise find Connery has failed to sufficiently

22   demonstrate that Boucher's claims 42-43 and 45 are unpatentable for lack of

23   written description.

1   *Boucher's Claim 44*

2   For Boucher's claim 44, Connery also argues that Boucher's application

3   fails to describe the additional limitation when the limitation is construed in the

4   context of the Connery's Patent. (Connery Motion 2 at 11.) The following chart

5   compares Boucher's claim 44 and Connery's construction (*id.*):

6

Claim 44	Connery's Construction of Claim 44 (with emphasis)
The method of claim 41, including prior to receiving the packet, allocating the target buffer for a plurality of packets, and notifying the network interface of the allocated target buffer.	"before the <u>first</u> packet identified by the <u>flow specification</u> as responsive to the request is received..."

7

8   We do not find Connery's claim construction reasonable. While we

9   recognize that Boucher's dependent claim 44 has the similar language as

10 Connery's dependent claim 4, Boucher's independent claim 41 uses the non-copied

11 term "transmit control block" or "TCB" whereas Connery's independent claim 1

12 uses the term "flow specification." As discussed previously, we interpret the

13 contested limitation that contains the non-copied term "transmit control block" or

14 "TCB," and operations applied to the object defined by the non-copied term, in

15 view of Boucher's specification, rather than Connery's patent.

16   Moreover, interpreting Boucher's dependent claim 44 in the context of

17 Connery's patent to require the packet to be identified by the **flow specification**

18 would be unreasonable. Boucher does not use the term "flow specification" in its

1   application or any of its claims. As discussed previously, Connery's term "flow

2   specification" is not an art recognized term with fixed meaning, but rather has a

3   unique meaning as used in Connery's patent. Connery again improperly imports

4   additional limitations from Connery's patent into Boucher's claim. *Phillips*,

5   415 F.3d at 1323.

6   　　　We also do not agree with Connery that the term "packet" should be

7   interpreted as the "**first** packet." Connery has not directed us to where in

8   Boucher's specification that has an express definition redefining the claim term

9   "packet" to the "**first** packet." In absence of such definition, one of ordinary skill

10 in the art would not have interpreted the term "packet" as the "**first** packet." As

11 such, the claim limitation in Boucher's claim 44 should not be interpreted to mean

12 "before the <u>first</u> packet identified by the <u>flow specification</u> as responsive to the

13 request is received."

14 　　　Accordingly, Connery fails to interpret Boucher's claim limitation in light of

15 Boucher's specification without improperly importing limitations into the claim.

16 We additionally do not find Connery's other arguments persuasive because they

17 are based on the improper claim construction (*e.g.*, Connery argues that Boucher's

18 allocation does not take place before the **first** packet of the plurality of packets

19 arrives because for "the TCP connection to already exist and a TCB match to

20 occur, the **initial set up** packets must have been exchanged before the TCB

21 reached the 'steady state' and was transferred to the INIC" (Connery Motion 2 at

22 13, emphasis added)). Thus, Connery fails to establish that Boucher's claim 44 is

23 unpatentable for lack of written description.

1   *Boucher's Claim 46*

2   For claim 46, Connery additionally argues that Boucher's application fails to

3   describe the step of "notifying the network interface in response to the request of

4   the TCB for the block of data" as recited in the claim because "there is no

5   description of a TCB that is set up with the request for the block of data."

6   (Connery Motion 2 at 15.) According to Connery, Boucher's "INIC examines the

7   incoming packets to determine if they are candidate for the 'fast-path' process even

8   before a TCB for the connection exists" and the control over the "connection is

9   passed to the INIC by writing the TCB to the INIC cache after the host determines

10   the TCP/IP connection is in steady-state." (*Id.*)

11   In response, Boucher points out that its provisional application describes the

12   following: (1) "passing to the INIC a TCP context identifier in response to a read

13   or write request," and (2) an example in which "a TCB would be passed out to

14   INIC in response to the read request." (*Id.* citing Boucher's provisional application

15   21:28-36.) The cited portion of Boucher's provisional application (Exhibit 1005

16   21:28-36) provides the following:

17   Once the INIC has passed up an indication with an NETBIOS length
18   greater than the amount of data in the packet it passed, it will continue
19   to accumulate further incoming data in DRAM on the INIC. Overflow
20   of INIC DRAM buffers will be avoided by using a receive window on
21   the INIC at this point, which can be 8K.

22   On receiving the indicated packet, the ATCP driver will call the
23   receive handler registered by the TDI client for the connection,
24   passing the actual size of the data in the packet from the INIC as
25   "bytes indicated" and the NETBIOS length as "bytes available."
26

1   We agree with Connery that the Boucher's application does not describe

2   "notifying the network interface in response to the request of the TCB for the block

3   of data" as recited in claim 46. The portion of Boucher's provisional application

4   cited by Boucher does not provide such teaching or any description that the TCB is

5   being provided for a specific block of data. While we considered Boucher's

6   witness Tal Lavian's testimony, we give little weight to Lavian's testimony

7   (Exhibit 1051 ¶¶ 538-542) because it merely provides conclusory statements

8   without providing a sufficient factual basis for the conclusion. Accordingly,

9   Connery has sufficiently demonstrated that Boucher's claim 46 is unpatentable

10   under 35 U.S.C. § 112, first paragraph, for lack of written description.

11   *Boucher's Claim 47*

12   For claim 47, Connery further argues that Boucher's application fails to

13   describe "the TCB includes a sequence number of a first byte from a plurality of

14   packets to be stored in the target buffer" as recited in the claim. (Connery Motion

15   2 at 15.) In particular, Connery alleges that Boucher's current send and receive

16   sequence numbers disclosed in Boucher's provisional application are not "a

17   sequence number of a first byte from a plurality of packets to be stored in the target

18   buffer." (*Id.* at 16.)

19   We agree with Connery that the Boucher's application does not describe the

20   limitation recited in claim 47. Boucher has not directed us to where in the

21   application that describes such feature. (Boucher Opposition 2 at 11-12.)

22   In response to Connery, Boucher states that its parent application and

23   provisional application that have been incorporated by reference in its involved

1 application, disclose a TCP connection. (Boucher Opposition 2 at 11.) According

2 to Boucher, a TCP connection includes a receive next sequence number, and

3 before packets have been received responsive to a read request, the receive next

4 sequence number is the "sequence number of a first byte from a plurality of

5 packets to be stored in the target buffer." (*Id.*, citing RFC 793 19:32.) The cited

6 portion of RFC 793 (page 19) provides the following:

7   The maintenance of a TCP connection requires the remembering of several
8   variables. We conceive of these variables being stored in a connection
9   record called a Transmission Control Block or TCB. Among the variables
10   stored in the TCB are the local and remote socket numbers, the security and
11   precedence of the connection, pointers to the user's send and receive buffers,
12   pointers to the retransmit queue and to the current segment. In addition
13   several variables relating to the send and receive sequence numbers are
14   stored in the TCB.
15
16   We are not persuaded by Boucher's argument. In Boucher's Opposition 1

17 (page 26), Boucher previously states that "[t]he protocol standard [RFC793] (Exh.

18 1006 and 2011) defines the notion of a TCB and suggests some of the contents, but

19 the implementation of a TCB can vary" citing to Comer and Stevens,

20 "Internetworking with TCP/IP," Vol. II, p. 166 (1991) (Exhibit 2010) (the relevant

21 portion is reproduced in our analysis for Connery Motion 1). By citing to RFC 793

22 rather than its application in its argument, Boucher has not established that its TCB

23 implementation includes a receive next sequence number. As such, Boucher has

24 not sufficiently explained how the TCB as implemented in its application

25 necessarily includes a sequence number of a first byte from a plurality of packets

26 to be stored in the target buffer.

1   Accordingly, Connery has sufficiently demonstrated that Boucher's claim 47

2   is unpatentable under 35 U.S.C. § 112, first paragraph, for lack of written

3   description.

4   *Boucher's Claims 48 and 49*

5   For claim 48, Connery argues that Boucher fails to describe "the TCB

6   includes a sequence number for the block of data" as recited in the claim.

7   (Connery Motion 2 at 16.) Specifically, Connery argues that Boucher's current

8   send and receive sequence numbers are for the "connection itself" rather than for

9   "the block of data" as recited in claims. (*Id.*) We agree.

10   Boucher has not directed us to where in Boucher's application that describes

11   "the TCB includes a sequence number for the block of data" as recited in claim 48.

12   (Boucher Opposition 2 at 11-12.) Moreover, Boucher does not sufficiently explain

13   how the TCB as implemented in its application necessarily includes a sequence

14   number for the block of data. Referencing to Lavian's testimony (Exhibit 1051

15   ¶¶ 549-550), Boucher states that a sequence number for the block of data could

16   be any sequence number for the block of data, and as data is received, the

17   receive next sequence number in the TCB would be incremented and pass

18   through each of the sequence numbers for the block of data. (Boucher

19   Opposition 2 at 12.) However, we give little weight to Lavian's testimony

20   (Exhibit 1051 ¶¶ 549-550) because it merely provides conclusory statements

21   without providing a sufficient factual basis for the conclusion.

22   Accordingly, Connery has sufficiently demonstrated that Boucher's claim 48

23   is unpatentable under 35 U.S.C. § 112, first paragraph, for lack of written

1 description. Because claim 49 depends on claim 48, we also find that Connery has

2 sufficiently demonstrated that claim 49 is unpatentable for lack of written

3 description.

4   Conclusion

5   For the forgoing reasons, Connery has sufficiently demonstrated that

6 Boucher's claims 46-49 are unpatentable under 35 U.S.C. § 112, first paragraph,

7 for lack of written description.

8   Connery however has failed to establish a prima facie case that Boucher's

9 originally-filed disclosure would not have reasonably conveyed to a person of

10 ordinary skill in the art at the time of the invention that Boucher had possession of

11 the invention recited in claims 41-45.

12   Accordingly, Connery's Motion 2 is **granted** as to claims 46-49, but **denied**

13 as to claims 41-45.

14 C.   Connery's Motion 3
15   Seeking to Deny the Accorded Benefit

16   Pursuant to 37 C.F.R. § 121(a)(1)(ii), Connery seeks to deny Boucher the

17 accorded benefit of the filing dates of Boucher's prior-filed applications[1] for

18 Count 1, which is defined as Boucher's claim 41 or Connery's claim 1, and

19 Count 2, which is defined as Boucher's claim 44 or Connery's claim 4 (Paper 20

20 at 2). To be sufficient, a motion must provide a showing, supported with

21 appropriate evidence, such that, if unrebutted, it would justify the relief sought.

---

[1] Boucher's parent application 09/067,544, issued as patent 6,226,680, and
Boucher's provisional application 60/061,809, filed on Oct. 14, 1997.

1 37 C.F.R. § 208(b). As the moving party, Connery has the burden of proof by a

2 preponderance of the evidence. 37 C.F.R. § 121(b); *see also Bosies v. Benedict,*

3 27 F.2d 539, 541-42 (Fed. Cir. 1994).

4   The principle issue is whether Boucher's prior-filed applications include a

5 disclosure of an embodiment within each count that meets the written description

6 requirement. *Hunt v. Treppschuh,* 523 F.2d 1386, 1387 (CCPA 1975); *Frazer v.*

7 *Schlegel,* 498 F.3d 1283, 1287 (Fed. Cir. 2007). In order to meet its burden,

8 Connery must demonstrate that Boucher's prior-filed applications fail to disclose

9 an embodiment that anticipates Boucher's claim 41 as to Count 1, and also fail to

10 disclose an embodiment that anticipates Boucher's claim 44 as to Count 2.

11   According to Connery, it has shown in Connery's Motion 2 that Boucher's

12 application (incorporated by reference Boucher's prior-filed applications) does not

13 satisfy the written description requirement with respect to any of the Boucher's

14 claims 41-49. (Connery Motion 3 at 4.) Connery contends that since its analysis

15 takes into account the disclosures of Boucher's prior-filed applications, it has

16 thereby demonstrated that Boucher's prior-filed applications fail to satisfy the

17 written description requirement as to Counts 1 and 2. *Id.*

18   We disagree. First, accorded benefit is not, strictly speaking, a written-

19 description test since only a single embodiment is required. *Hunt,* 523 F.2d

20 at 1387; *Frazer,* 498 F.3d at 1287. Second, as discussed previously in our analysis

21 for Connery's Motion 2, Connery fails to demonstrate sufficiently that Boucher's

22 claims 41 and 44 (*i.e.,* Counts 1 and 2) are unpatentable under 35 U.S.C. § 112,

23 first paragraph, for lack of written description.

24   Accordingly, Connery's Motion 3 has failed to establish a prima facie case

1 that Boucher's prior-filed applications fail to disclose an embodiment that

2 anticipates each count. Connery's Motion 3 is **denied**.

3 E.   Boucher's Motion 2
4   Seeking to Combine Counts 1 and 2

5   Per the order re-declaring the interference (Paper 20), dated November 22,

6 2010, Count 1 is defined as Boucher's claim 41 or Connery's claim 1, and Count 2

7 is defined as Boucher's claim 44 or Connery's claim 4. Boucher asserts that

8 Counts 1 and 2 are improper because they are not patentably distinct from each

9 other.

10   According to 37 C.F.R. § 41.201, where there is more than one count, each

11 count must describe a patentably distinct invention. Because the patentable

12 distinction can be in either direction to support separate counts, Boucher must

13 demonstrate two-way non-distinction. In the direction from Count 2 to Count 1,

14 patentable non-distinction can be presumed because Connery's claim 4 depends

15 from Connery's claim 1. That means in its Motion 2, Boucher must only

16 demonstrate patentable non-distinction going from Count 1 to Count 2, for

17 example, from Connery's claim 1 to Connery's claim 4. Thus, Boucher as the

18 moving party must satisfy its burden of proof by a preponderance of the evidence

19 that given Connery's claim 1 as prior art, Connery's claim 4 would have been

20 obvious to one with ordinary skill in the art.

21   Connery's claim 1 was reproduced earlier in this opinion. Connery's claim

22 4 depends directly from Connery's claim 1 and reads as follows:

23   4.   The method of claim 1, including prior to receiving the
24   packet, allocating the target buffer for the plurality of packets, and
25   notifying the network interface of the allocated target buffer.

1   The difference between Connery's claim 4 and claim 1 is the recitation in

2   claim 4 of two additional steps which are stated as performed "prior to receiving

3   the packet," and which are:

4   1.   allocating the target buffer for the plurality of packets; and

5   2.   notifying the network interface of the allocated target buffer.

6   At the outset, we dismiss two arguments which are plainly without merit.

7   First, Boucher asserts that Connery's claim 4 is indefinite under 35 U.S.C.

8   § 112, second paragraph, and that according to a prior decision of the Board,

9   *Fritsch v. Lin*, 21 USPQ2d 1739, 1742 (Bd. Pat. App. & Int. 1991), an indefinite

10   claim cannot be deemed patentably distinct from an existing count and thus

11   designated as not corresponding to that count. In its list of proposed motions to be

12   filed, Boucher did not indicate a desire to file a motion alleging indefiniteness of

13   Connery's claim 4 under 35 U.S.C. § 112, second paragraph. Boucher also has not

14   been authorized to file a motion asserting indefiniteness of Connery's claim 4.

15   Thus, in this proceeding Boucher may not argue that Connery's claim 4 is

16   indefinite. To the extent Boucher has submitted the argument, we decline to

17   entertain it. Also, *Fritsch v. Lin* is not a precedential decision of the Board and

18   thus is non-binding. Even if it is binding, the facts there are distinguishable from

19   those here for another reason, *i.e.*, Connery's claim 4 already corresponds to a

20   count, Count 2, and is not in the same status as claims in *Fritch v. Lin* which did

21   not correspond to a count. Furthermore, the analysis in *Fritch v. Lin* is expressly

22   based on rules and guidance that no longer exist. The issue of leaving an indefinite

23   claim out of the interference is non-existent here.

1   Moreover, that a claim term lacks antecedent basis for an indefinite article

2   "the" does not automatically indicate indefiniteness. Only a reasonable degree of

3   precision and particularity is required by 35 U.S.C. § 112, second paragraph. *In re*

4   *Johnson*, 558 F.2d 1008, 1016 (CCPA 1977). Definiteness of the language must

5   be analyzed not in a vacuum but always in light of the teachings of the prior art and

6   of the particular application disclosure as it would be interpreted by one possessing

7   ordinary skill in the art. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

8   Secondly, Connery asserts that Boucher has a "heavy burden" because prior

9   to the declaration of interference Boucher had proposed separate counts defined

10   respectively by Connery's claims 1 and 4, with one term change that substitutes

11   "communication control information" for "flow specification" in those claims. We

12   reject the notion that Boucher now somehow has a heavier burden than it otherwise

13   would have if it had not proposed the counts that it did propose prior to the

14   declaration of interference. No matter which counts were previously proposed by

15   Boucher prior to declaration of the interference, Boucher's burden of persuasion

16   for this motion is the same, by a preponderance of the evidence.

17   However, it appears that by "heavy burden" Connery might have meant only

18   that because the differences between two counts previously proposed by Boucher

19   are the same as those between Counts 1 and 2, then the lack of explanation for the

20   previous position renders Boucher's submission here less than satisfying. If so, we

21   agree, especially in light of the conclusory testimony of Boucher's technical

22   witness as will be discussed below.

23   The recitation "the plurality of packets" in Connery's claim 4 has no

24   antecedent basis. Boucher's interpreting the term as "a plurality of packets" is

1   reasonable and not contradicted in any meaningful manner by Connery. We adopt

2   the same interpretation and note that Connery's Opposition 2 presents no

3   alternative interpretation. Thus, as compared to Count 1, Count 2 additionally

4   requires two additional steps which are performed **"prior to receiving the**

5   **packet"**:

6   1.   allocating the target buffer for a plurality of packets; and

7   2.   notifying the network interface of the allocated target buffer.

8   Boucher asserts that the first of the above-noted difference would simply

9   have been obvious to one with ordinary skill in the art, relying on Paragraph Nos.

10   246-252 of the declaration of its technical witness Tal Lavian (Exhibit 1003) which

11   are reproduced below:

12   (246)   The plain grammar of Connery's claim 1 strongly implies that
13   "the target buffer" was allocated "prior to receiving the packet."
14
15   (247)   This is so because claim 1 recites "transferring the data
16   payload in the packet directly to a target buffer assigned by a process
17   at a layer higher than the network layer." Exhibit 1002, claim 1.
18
19   (248)   The word "assigned" is either the past tense or past
20   participle of the word "assign."
21
22   (249)   Thus, the word "assigned" in claim 1 implies that the
23   "target buffer" was already "assigned" (i.e., "allocated").
24
25   (250)   The recitation of "transferring the data payload in the
26   packet directly" to the "target buffer" also implies that the "target
27   buffer" was already "assigned" (i.e., "allocated").
28

1   (251) This is so because the "target buffer" was available for
2   direct transfer of the "payload data," as opposed to waiting until after
3   the "target buffer" had been assigned.
4
5   (252) Thus, this difference of "prior to receiving the packet,
6   allocating the target buffer for the plurality of packets" between
7   Connery's claim 4 and Connery's claim 1 would have been simply
8   obvious to a POSITA [person with ordinary skill in the art].
9
10   The fact that Mr. Lavian provided no less than six paragraphs of testimony

11   of the pertinent issue does not mean his testimony is not largely conclusory and

12   lack adequate explanation. That is so because all the paragraphs strung together

13   still leave large gaps and do not set forth a logical and adequate explanation.

14   While it is true that the word "assigned" is the past tense or the past

15   participle of "assign" and that the target buffer is "already assigned," the key lies in

16   identity of the base time frame with respect to which "past" is determined. That

17   time frame may be the time of receipt of the data packet as is required by claim 4,

18   or it may be the time of transfer of the packet to the target buffer, or it may be

19   another time frame between receipt of the packet and transfer of the packet to the

20   target buffer.

21   Mr. Lavian states that the plain grammar of Connery's claim 1 strongly

22   implies that the target buffer was allocated prior to receiving the packet because

23   claim 1 recites "transferring the data payload in the packet directly to a target

24   buffer assigned by a process at a layer higher than the network layer." There is

25   insufficient explanation. Transferring the packet directly to a target buffer

26   assigned by a process at a higher level than the network layer does not require the

27   target buffer's being allocated prior to receiving the data packet. It is also not

1   incompatible or inconsistent with allocating the buffer after receipt of the packet.

2   Claim 1 does not recite that there be no action taken whatsoever between receiving

3   the data packet and transferring the data packet to the target buffer.

4   Mr. Lavian states that the recitation of "transferring the data payload in the

5   packet directly" to the target buffer implies that the target buffer was already

6   assigned because the target buffer was available for direct transfer of the payload

7   data "as opposed to waiting until after" the target buffer has been assigned. There

8   is insufficient explanation. The "directly to a target buffer" language in claim 1

9   reasonably means, in the context of Connery's specification, bypassing

10 intermediate buffers and not necessarily excluding all other activities such as the

11 allocation of the target buffer after receipt of the data packet.

12   We find Mr. Lavian's above-quoted testimony superficial and lacking in

13 meaningful explanation.

14   Boucher asserts that the second of the above-noted difference would simply

15 have been obvious to one with ordinary skill in the art, relying on Paragraph Nos.

16 253-256 of the declaration of its technical witness Tal Lavian (Exhibit 1003) which

17 are reproduced below:

18   (253) The recitation in Connery's claim 4 of "notifying the
19   network interface of the allocated target buffer" is also implied by
20   Connery's claim 1.
21
22   (254) This is so because, according to claim 1, the "target
23   buffer (was) assigned by a process at a layer higher than the network
24   layer," and the "network layer" is part of the "multi-layer network
25   protocol" executing on the "end station." Exhibit 1002, claim 1.
26

1   (255) Accordingly, the "layer higher than the network layer"
2 and the "target buffer" would have been expected to be on the "end
3 station," which would need to "notify ... the network interface of the
4 allocated target buffer" so that the "network interface" could
5 "determine(e) . . . whether the packet matches a flow specification."
6
7   (256) Thus, this difference between Connery's claim 4 and
8 Connery's claim 1 would also have been simply obvious to a POSITA
9 [person with ordinary skill in the art].
10
11 Mr. Lavian states that "notifying the network interface of the allocated target

12 buffer" is implied by Connery's claim 1 for the reasons stated in above-quoted

13 Paragraph Nos. 254-256. The statement is misplaced because at issue is not the

14 limitation of notifying the network interface of the allocated target buffer, but the

15 "prior to receiving the packet" requirement for performing the notification as is

16 recited in Connery's claim 4. Mr. Lavian's testimony misses the issue and fails to

17 address the specific timing requirement for performing the notification. We do not

18 see how or why the specific timing requirement is "implicit" in Connery's claim 1.

19 Paragraphs 254-256 of Mr. Lavian's testimony do not persuade us that the timing

20 requirement is implicit in Connery's claim 1.

21 Mr. Lavian continues to testify in Paragraphs 259-260 of his declaration

22 (Exhibit 1003) that Connery's specification does not provide any example (1) of

23 allocating the target buffer for a plurality of packets "after" receiving the packet for

24 which the data payload is transferred directly to the target buffer or (2) of not

25 notifying the network interface of the allocated target buffer. Again, we note that

26 the pertinent feature about notifying the network interface of the allocated buffer is

27 the timing of the notification and not mere notification itself. More importantly,

1 what specific examples are disclosed in Connery's specification is of little or no

2 value in determining what would have been obvious to one with ordinary skill in

3 the art, since the Connery specification does not constitute prior art. Boucher is

4 not citing to Connery's specification in this context for interpreting a Connery

5 claim. If Connery's specification were prior art, then Connery's claim 4 indeed

6 would have been obvious over Connery's claim 1 and the obviousness inquiry

7 would be a non-starter because Connery's specification presumably provides a

8 written description of the invention of both Connery's claims 1 and 4. Boucher's

9 analysis is misplaced.

10   For all of the foregoing reasons, Boucher has not satisfied its burden of

11 proof by a preponderance of the evidence.

12   Boucher's Motion 2 is **denied**.

13 F.   Boucher's Motion 3
14   Seeking to Designate Connery's Claims 10-20 as Corresponding to Count 1
15
16   If Counts 1 and 2 are combined as new Count 4 as requested in Boucher's

17 Motion 2, Boucher would like to designate Connery's claims 10-20 as

18 corresponding to Count 4. However, that scenario did not materialize. So

19 Boucher's Motion 3 seeks to designate those claims as corresponding to Count 1.

20 In making its showing, Boucher applies Connery's claim 1 as the count. Per

21 37 C.F.R. § 41.207, a claim corresponds to a count if the subject matter of the

22 count, treated as prior art, would have anticipated or rendered obvious the subject

23 matter of the claim.

24   We first discuss several misplaced arguments of Boucher.

1   First, citing *Fritsch v. Lin*, 21 USPQ2d 1739, 1742 (Bd. Pat. App. & Int.

2   1991), Boucher first asserts (Motion 4:13 to 5:3) that a claim which is indefinite

3   under 35 U.S.C. § 112, second paragraph, cannot be designated as not

4   corresponding to an existing count but must be regarded as corresponding to a

5   count. We already discussed above that in its list of proposed motions to be filed,

6   Boucher did not indicate a desire to file a motion alleging indefiniteness of

7   Connery's claim 10 under 35 U.S.C. § 112, second paragraph. Connery also has

8   not been authorized to file a motion asserting indefiniteness of Connery's claim 10.

9   Thus, Boucher may not argue that Connery's claim 10 is indefinite. We decline to

10 entertain it. Also, *Fritsch v. Lin* is not a precedential decision of the Board and

11 thus is non-binding. In any event, that a claim term lacks antecedent basis for an

12 indefinite article "the" does not automatically establish indefiniteness. Only a

13 reasonable degree of precision and particularity is required by 35 U.S.C. § 112,

14 second paragraph. *In re Johnson*, 558 F.2d at 1016.

15 Secondly, in many instances, it is evident that Boucher is treating the

16 entirety of Connery's specification including even the subject matter of dependent

17 claims as prior art combinable with Count 1 to render Connery's claims 10-20

18 obvious over Count 1. That is inappropriate. For example, Boucher states (Motion

19 6:8-12):

20   ..., which was referenced repeatedly in Connery's specification, and
21   **if the POSITA** [person with ordinary skill in the art] **had as part of**
22   **the POSITA's "background knowledge" the recitation in claim 3**
23   that the network protocol can include TCP and IP layers, then the
24   POSITA would have found it implied and obvious that a MAC layer
25   was underlying the IP layer. MF(43). (Emphasis added.)
26

1   As a further example, we note that Boucher states (Motion 12:19 to 13:4):

2   Claim 2 recites that the control field "includes a packet header," and
3   claim 3 recites that the control field "comprises a TCP/IP packet
4   header," so that a POSITA looking at claims 1, 2 and 3 would know
5   that packets received in accordance with the TCP/IP network protocol
6   would be likely to have data payloads and TCP/IP headers. MF (90).
7

8   The subject matter of Connery's claims 2-9 do not constitute prior art. Nor

9 is the disclosure of Connery's specification.

10   Third, Boucher uses the phrase "within the scope and content of Count 1"

11 frequently and in a nebulous and confusing manner. It appears that according to

12 Boucher, a feature recited in a Connery claim dependent from claim 1 is within the

13 scope and content of Count 1 selected as Connery's claim 1. For example, noting

14 first that Connery's claim 6 recites a feature similar to that of Connery's claims 10

15 and 16, Boucher then states:

16   The substance of this recitation is within the scope and content
17   of Count 1 because the statement of Connery claim 6 is part of the
18   scope and content of Count 1, and because Connery claim 6 describes
19   "notifying the network interface . . . of a flow specification." MF
20   (66). "Providing" the flow specification to the network interface as
21   recited in claims 10 and 16 is just one way of carrying out claim 1's
22   slightly broader notion of "notifying" the network interface of the
23   flow specification. MF (67).
24

25   Boucher regards subject matter not specifically recited in but encompassed

26 by an independent claim to be part of the scope and content of the independent

27 claim. But that is not an adequate basis to conclude that the independent claim,

28 such as claim 1, teaches or renders obvious the encompassed but unrecited feature.

1   It is confusing for Boucher to refer to an encompassed but unrecited feature as part

2   of the scope and content of Count 1. What does that mean? There is no dispute

3   that Connery's claim 1 is broader than and encompasses claims 2-9 which depend

4   from claim 1. An independent claim applied as prior art also does not

5   automatically render obvious anything and everything encompassed within its

6   scope. Boucher's approach is unhelpful and establishes nothing meaningful in

7   support of its motion.

8   Having a scope broader than or encompassing the subject matter of another

9   claim is not sufficient basis to support an assertion of anticipation of the subject

10 matter of that other claim. We reject outright the anticipation portion of Boucher's

11 assertion of "anticipated or rendered obvious" relationship in the direction of

12 Connery's claim 1 to Connery's claims 10-20. Anticipation requires that each and

13 every element as set forth in the claim is found, either expressly or inherently

14 described, in a single prior art reference. *In re Robertson*, 169 F.3d 743, 745 (Fed.

15 Cir. 1999); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir.

16 1987). Each and every element, arranged in a combination precisely as is recited

17 in the claim, must be found in a single prior art reference. *Karsten Manufacturing*

18 *Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). Boucher has

19 made no such showing for any of Connery's claims 10-20 based on Connery's

20 claim 1 as prior art.

21   Despite the deficiencies noted above, however, Boucher has satisfied its

22 burden of proof by a preponderance of the evidence for designating Connery's

23 claims 10-20 as corresponding to Count 1. That is because the differences between

24 each of Connery's claims 10-20 and Connery's claim 1 are not substantial or

1   significant from the perspective of one with ordinary skill based on Boucher's

2   discussion of the level of ordinary skill in the art and of the particular prior art

3   identified in Connery's specification. That Connery's specification is not prior art

4   does not mean applicable prior art are somehow disqualified once they are

5   mentioned in Connery's specification. We credit the testimony of Boucher's

6   witness Tal Lavian with regard to such prior art.

7   Claims 10 and 20 are independent claims. Boucher asserts that Connery's

8   claim 1 renders obvious Connery's claims 10 and 16.

9   It cannot be reasonably disputed that at the time of the parties' invention, it

10   was well known in the field of network data communications that data transfer is

11   commonly through a multi-layer protocol or a protocol stack as is specifically

12   noted in Connery's claim 1. It also cannot be reasonably disputed that a typical

13   such prior art multi-layer protocol includes, in ascending order, the physical layer,

14   the datalink layer, the network layer, the transport layer, and the application layer,

15   as are identified in the background portion of Connery's specification. (Exhibit

16   1002 1:12-16). Modem communication standards, such as the Transfer Control

17   Protocol (TCP) and the Internet Protocol (IP) were well known in the art. (Exhibit

18   1002 1:17-20). Various protocols were known to be executable at each layer and

19   the particular protocols used at each layer were mixed and matched by design to

20   create a desirable protocol stack for operation of a communication channel.

21   (Exhibit 1002 1:20-25). The foregoing is indicative of the level of ordinary skill at

22   the pertinent time.

23   Paragraph 276 of the declaration testimony of Boucher's technical witness

24   Tal Lavian states (Exhibit 1003):

1   (276) From his or her background knowledge, the POSITA
2   [person with ordinary skill in the art] would have known that a stack
3   that involves TCP and IP layers necessarily has a Medium Access
4   Control (MAC) layer below the IP layer.
5
6   We do not credit Paragraph 276 of Tal Lavian's testimony in full to find that

7 a stack that involves TCP and IP layers necessarily has a Medium Access Control

8 (MAC) layer below the IP layer, but do credit it in part to find that a stack that

9 involves TCP and IP layers typically or usually has a Medium Access Control

10 (MAC) layer below the IP layer. To urge that an element is "necessarily" present

11 requires more explanation of the basis for that assertion.

12   Furthermore, we credit the following testimony of Boucher's technical

13 witness Tal Lavian, in these numbered paragraphs of his declaration (Exhibit

14 1003):

15   (273) A POSITA [person with ordinary skill in the art] would
16   have known that the transport layer of the "multi-layer protocol" can
17   be TCP.
18
19   (274) Further, the POSITA [person with ordinary skill in the
20   art] would have known that IP can be the network layer protocol.
21
22   Comparing the preambles of claims 10 and 16 with that of base claim 1 as

23 the count, we note that while claim 1 recites a method for transferring data on a

24 network executing multi-layer network protocol, claim 16 recites a method for

25 transferring data on a TCP/IP network executing a multi-layer network protocol

26 and claim 10 recites a method for transferring data on a multi-layer network.

27 Based on our findings above on the level of ordinary skill and what a person with

28 ordinary skill would have known, the general method of claim 1 which executes

1   multi-layer network protocol on a network would have reasonably suggested to one

2   with ordinary skill a TCP/IP network recited in claim 16 and a multi-layer network

3   recited in claim 10. Both claims 10 and 16 further recite "including medium

4   access control layer processes" and claim 16 specifies the medium access control

5   layer processes are "below TCP/IP." In that regard, we have already found that a

6   protocol stack that includes TCP and IP layers typically also includes a Medium

7   Access Control (MAC) layer below the IP layer. Also, based on our findings

8   above, a network layer implemented with IP is already below a transport layer

9   implemented with TCP. The differences between the preambles are insubstantial.

10   Claim 10 includes an initial step of "establishing a connection with a

11 destination for a session according to a network protocol." Claim 16 includes an

12 initial step of "establishing a connection with a destination for a session according

13 to the TCP/IP network protocol." We agree with Boucher that one with ordinary

14 skill in the art would have known that in a method for transferring data on a

15 network that executes a multi-layer protocol, a step would be needed which

16 establishes a connection for a session according to a network protocol and if that

17 protocol is TCP/IP then a step would be needed which establishes a session

18 according to the TCP/IP protocol. Boucher's position is supported by citation to

19 RFC 793 (Exhibit 1006, page 5, lines 15-29) and by the testimony of Tal Lavian

20 (Exhibit 1003 ¶¶ 306 and 307).

21   Claim 1 as prior art already recites transferring data from a data source to an

22 end station and receiving in the network interface a packet which carries a data

23 payload from a block of data in the data source. Both claim 10 and claim 16

24 additionally recites transmitting a request for transfer of a block of data from the

1   data source, and claim 16 specifies that the request is "from a application." In that

2   connection, Boucher asserts that one with ordinary skill in the art would have

3   known that the transfer of a block of data according to established protocols begins

4   with transmitting a request for transfer of a block of data from the data source.

5   Boucher cites to paragraph 3.9.35 of CIFS/1.0 [Common Internet File System]

6   dated June 13, 1996, which states (Exhibit 1020 at 105, lines 5-7):

7   The server will respond, in one send, with the raw data being read.
8   Thus the client is able to request up to 65,535 bytes of data and
9   receive it directly into the user's buffer, . . .
10
11   Boucher's assertion is also supported by the declaration testimony of its

12 technical witness. Tal Lavian states that one with ordinary skill in the art would

13 have known that the transfer of a block of data begins with a request for transfer of

14 a block of data from the data source and that one with ordinary skill in the art

15 would have expected that transferring data on a network from a data source to an

16 end station executing a multi-layer network protocol would include a step of

17 transmitting a request from an application for transfer of a block of data. (Exhibit

18 1003 ¶¶ 311 and 312). Tal Lavian further identifies specific examples of such

19 applications in the prior art. He states (Exhibit 1003 ¶ 313):

20   CIFS is one example of an application that utilizes such a
21   request/reply protocol; File Transfer Protocol (FTP) and Network File
22   System (NFS) are other examples that would have been well known to
23   a POSITA [person with ordinary skill in the art].
24
25   Both claims 10 and 16 further recites providing to the network interface a

26 flow specification and an identifier of a target buffer. Claim 16 further modifies

27 the term "flow specification" with the phrase "for the block of data." Boucher

1   points out that according to claim 1, a flow specification is already located at some

2   time in the network interface because it is the network interface that determines

3   whether a received packet matches a flow specification. Thus, Boucher asserts that

4   for the network interface to perform the determining step recited in claim 1, the

5   network interface must have, at some time, been provided with a flow

6   specification, and Boucher notes that it is implicit that the flow specification

7   provided is "for the block of data" as recited in claim 16 because the determining

8   step of claim 1 is attempting to match a packet that carries a data payload from the

9   block of data.

10   We agree with Boucher. The above-noted positions are not only logical but

11   also supported by the declaration testimony of its technical witness Tal Lavian. In

12   his declaration, Tal Lavian states that one with ordinary skill in the art would have

13   expected the end station to provide a flow specification to the network interface

14   because it is the network interface which determines whether the packet matches a

15   flow specification (Exhibit 1003 ¶ 320), and that the additional recitation in claim

16   16 that the flow specification is "for the block of data" is implied by claim 1

17   because claim 1 recites that the data payload of the packet that matches the flow

18   specification is from the block of data. (Exhibit 1003 ¶ 321).

19   Both claims 10 and 16 further recite providing an identifier of a target buffer

20   to the network interface. Boucher's explanation of why that feature would have

21   been readily apparent to one with ordinary skill in the art, given claim 1 as prior

22   art, is logical and persuasive. We reproduce a portion of it below (Motion 10:2-

23   15):

1   Claim 1 says that the data payload of the incoming packet is to be

2   transferred "directly to" the target buffer, so it would have been

3   obvious to a POSITA [person of ordinary skill in the art] that the

4   network interface of claim 1 that is receiving the packet would have to

5   be provided with knowledge of where to place the data. MF (69).

6   Because claim 1 recites that the "target buffer" is "assigned by a

7   process at a layer higher than the network layer," a POSITA would

8   have expected that the target buffer is on the end station, which

9   executes the "network layer and at least one higher layer," and so the

10   end station would need to notify the network interface of the target

11   buffer. MF (70). The way an application in a conventional stack at

12   the time typically informed a lower layer of the stack where to place

13   data involved giving the lower layer of the stack a starting address of

14   a buffer or some other type of identifier of the buffer. This would

15   have been background knowledge well known to a POSITA. MF

16   (71). Thus, a POSITA would have known that one way a network

17   interface can be notified of an allocated target buffer is by providing it

18   with an identifier (for example, starting address) of the target buffer.

19   MF (72).

20

21   The above-quoted position of Boucher is supported by the testimony of Tal

22 Lavian. (Exhibit 1003 ¶¶ 326-329).

23   Claim 10 recites receiving in the network interface a plurality of packets

24 which carry respective data payloads and specify the packets as including control

25 fields identifying whether the packet falls within the flow specification of the block

26 of data. While it is true that claim 1 as prior art refers only to receiving a packet,

27 claim 1 refers to receiving that packet from a block of data in the data source. We

28 agree with Boucher that one with ordinary skill possesses a basic level of skill, and

29 that it would have been obvious to one with ordinary skill that more than one

30 packet from the block of data in the data source can be received in the same way.

1   That position is supported by the testimony of Tal Lavian, who states that it would

2   have been well known to one with ordinary skill in the art that if one packet can be

3   transferred in a certain way, then more than one packet can be transferred in the

4   same way. (Exhibit 1003 ¶ 337). In that regard, note that if one packet has a

5   control field identifying the packet, then other packets can be similarly structured.

6   As for claim 10's requirement that the control fields of the packets identify

7   whether the packet falls within the flow specification of the block of data, that

8   flows logically from claim 1's recitation of determining based on the control field

9   of the packet whether the packet matches the flow specification. Boucher's

10   technical witness Tal Lavian testifies that one with ordinary skill in the art would

11   have known from the "based on the control field" language of claim 1 that the

12   control field is used to identify whether a corresponding packet falls within the

13   flow specification. We credit the testimony. Boucher's stated positions are

14   persuasive.

15   Claim 16 recites receiving in the network interface a plurality of packets

16   which carry respective data payloads from the block of data in the data source and

17   specify that each packet includes a TCP/IP header. We have already explained

18   above that in light of disclosure in the prior art that one packet from a block of data

19   is transferred in a certain manner, one with ordinary skill in the art would have

20   known that more than one packet from the block can be similarly transferred.

21   As for claim 16's requirement that each packet includes a TCP/IP header, we

22   have already explained above in connection with the discussion of the preamble of

23   claim 16 that the preamble of claim 1 would have reasonably suggested to one with

24   ordinary skill in the art a TCP/IP network. Claim 1 as prior art also already recites

1   a control field identifying the packet. We agree with Boucher that one with

2   ordinary skill would have recognized that a control field for a packet transferred on

3   a TCP/IP network can be implemented as a TCP/IP header for each such packet.

4   With regard to the determining step recited in claims 1, 10, and 16, it is

5   noted that the language used in claims 10 and 16 is not exactly the same. For

6   instance, claim 1 recites the inquiry as whether the packet matches a flow

7   specification, and claims 10 and 16 recite the inquiry as whether the packet falls

8   within the flow specification. That is a difference without distinction, because in

9   the context of Connery's specification, there is no difference between "falling

10   within the flow specification" and "matching the flow specification." Also, it is

11   noted that claim 10 recites "upon receiving a packet" and claim 16 recites "upon

12   receiving each packet," just prior to reciting the determining step, while claim 1

13   does not have such "upon receiving" language. That is also a difference without

14   distinction because it is inherent that each packet has to be received before the

15   determination is made. It is also the case that one with ordinary skill in the art

16   would have known that if a received packet is processed in a certain way according

17   to claim 1 as prior art, then each received packet can be similarly processed if more

18   than one packet is received.

19   Claim 11 depends from claim 10 and additionally recites that the control

20   field in the first packet includes a packet header. Tal Lavian testifies that a person

21   with ordinary skill in the art would have naturally expected a control field in a

22   packet to include a packet header. (Exhibit 1003 ¶ 358). In that regard, the packet

23   header would simply be the area in the packet that does not hold the data payload

24   of the packet but stores the control field of the packet. We credit Lavian's

1 testimony. One with ordinary skill in the art possesses ordinary creativity and is

2 not an automaton. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). It

3 would have been naturally expected to store the control field of a packet in a

4 packet header that is separate from the data payload of the packet.

5 Claims 12 depends from claim 10 and recites that the network protocol

6 comprises TCP/IP and further recites that the packet control data comprises a

7 TCP/IP header. Boucher notes that similar limitations are present in claim 3 which

8 corresponds to Count 1. The correctness of that designation is presumed. We

9 agree with Boucher that there is no apparent reason why claim 3 should correspond

10 to Count 1 but not claim 12. Moreover, we have already explained above in

11 connection with the discussion of the preamble of claim 16 that the preamble of

12 claim 1 would have reasonably suggested to one with ordinary skill in the art a

13 TCP/IP network. Thus, we agree with Boucher's assertion, supported by the

14 testimony of Tal Lavian (Exhibit 1003 ¶¶ 366 and 376), that one with ordinary skill

15 in the art would have expected that the "multi-layer network protocol" of claim 1

16 comprises TCP/IP and that the control field comprises a TCP/IP header.

17 Claim 13 depends on claim 10 and additionally recites (1) that the network

18 protocol comprises TCP/IP, and that (2) that the flow specification includes a

19 sequence number of a first byte from the plurality of packets to be stored in the

20 target buffer. Boucher notes that similar limitations are present in claim 7 which

21 corresponds to Count 1. The correctness of that designation is presumed. We

22 agree with Boucher that there is no apparent reason why claim 7 should correspond

23 to Count 1 but not claim 13. Also, as explained above, one with ordinary skill in

24 the art, based on claim 1 treated as prior art, would have readily recognized that the

1   multi-layer network protocol can be TCP/IP. As for including in the flow

2   specification a sequence number of the first byte to be stored in the target buffer,

3   we credit the testimony of Tal Lavian (Exhibit 1003 ¶ 371) that a sequence number

4   would have been a well known way for one with ordinary skill in the art to identify

5   payload data according to TCP. Claim 1, treated as prior art, already requires the

6   provision of a flow specification with respect to which a received packet is

7   matched, and we have interpreted "flow specification" as requiring an

8   identification of the data block for transfer. Thus, claim 1 reasonably would have

9   suggested to one with ordinary skill inclusion in the flow specification a sequence

10   number for the first byte of each packet in the block.

11   Claim 14 depends from claim 10 and additionally recites wherein the flow

12   specification includes a sequence number for the block of data. Boucher notes that

13   a similar limitation is present in claim 8 which corresponds to Count 1. The

14   correctness of that designation is presumed. We agree with Boucher that there is

15   no apparent reason why claim 8 should correspond to Count 1 but not claim 14.

16   Also, we have determined above that claim 1 as prior art would have reasonably

17   suggested a multi-layer protocol including TCP/IP and a control field implemented

18   as a TCP/IP header. We further credit Tal Lavian's testimony (Exhibit 1003 ¶ 376)

19   that TCP/IP is a well known multi-layer network protocol and that TCP headers

20   include sequence numbers for all bytes of data to be stored.

21   We agree with Boucher that in light of the level of ordinary skill in the art,

22   one with ordinary skill would have regarded the sequence number for each byte as

23   a way for determining whether a packet matched a flow specification. Thus, it

24   would have been readily apparent to one with ordinary skill to include in the flow

1   specification a sequence number for each byte of data in the data block including

2   the first byte of the block. The position is supported by the testimony of Tal

3   Lavian. (Exhibit 1003 ¶ 377). A sequence number for each byte of data in the

4   block meets the requirement that there be a sequence number for the block of data.

5   Claim 17 depends on claim 16 and additionally recites that the flow

6   specification includes a sequence number for bytes of data in the block of data. In

7   the discussion of claim 14 above, we have determined that one with ordinary skill

8   would have regarded having a sequence number for each byte as a way for

9   determining whether a packet matched a flow specification and thus it would have

10   been readily apparent to one with ordinary skill to include in the flow specification

11   a sequence number for each byte of data in the data block. That is still true in the

12   context of claim 17 for which the base independent claim 16 refers not to matching

13   a packet to the flow specification but determining whether a packet falls within the

14   flow specification, because we have determined that in the context of Connery's

15   specification there is no meaningful difference between "falling within the flow

16   specification" and "matching the flow specification."

17   We have already explained above in connection with the discussion of the

18   preamble of claim 16 that the preamble of claim 1 would have reasonably

19   suggested to one with ordinary skill in the art a TCP/IP network. Claim 1 as prior

20   art also already recites a control field identifying the packet, and we have

21   determined that one with ordinary skill would have recognized that a control field

22   for a packet transferred on a TCP/IP network can be implemented as a TCP/IP

23   header for each such packet. We credit the testimony of Tal Lavian who states that

1   a person of ordinary skill in the art would have known that TCP headers include

2   sequence numbers for all bytes of data to be stored. (Exhibit 1003 ¶ 376).

3   Claim 15 depends on claim 14 which depends on claim 10. Claim 15

4   additionally recites: "wherein the flow specification includes IP source and

5   destination addresses and TCP port numbers." Boucher notes that similar

6   limitations are present in claim 9 which corresponds to Count 1. The correctness

7   of that designation is presumed. We agree with Boucher that there is no apparent

8   reason why claim 9 should correspond to Count 1 but not claim 15. More

9   importantly, we credit Tal Lavian's testimony (Exhibit 1003 ¶¶ 381 and 393) that

10   one with ordinary skill in the art would have expected that a flow specification

11   would include IP source and destination addresses and TCP port numbers because

12   IP source and destination addresses and TCP port numbers represent a well known

13   way to identify received data packets according to TCP. We have also determined

14   above that claim 1 as prior art reasonably would have suggested TCP/IP in the

15   multi-layer network. Accordingly, Boucher's argument that it would have been

16   readily apparent to one with ordinary skill to include in the flow specification IP

17   source and destination addresses and TCP port numbers has merit.

18   Claim 18 depends on claim 16 and like claim 15 which depends from claim

19   10 it additionally recites that the flow specification includes IP source and

20   destination addresses and TCP port numbers. We have already determined above

21   in connection with the discussion of claim 15 that to one with ordinary skill in the

22   art IP source and destination addresses and TCP port numbers represent a well

23   known way to identify received data packets according to TCP. We have also

24   determined above that claim 1 as prior art reasonably would have suggested

1   TCP/IP in the multi-layer network. Thus, we agree that it would have been readily

2   apparent to one with ordinary skill that a flow specification would include IP

3   source and destination addresses and TCP port numbers.

4   Claim 19 depends on claim 16 and additionally recites: "the target buffer

5   comprises a buffer assigned at the TCP layer or higher." Claim 20 depends on

6   claim 16 and additionally recites: "the target buffer comprises a buffer assigned at

7   a layer higher than the TCP layer." Boucher argues that subject matter similar to

8   the feature additionally recited in claims 19 and 20 are already found in claims 1,

9   3, 7, and 9. The argument is misplaced. With respect to claims 19 and 20, for

10   purposes of this motion it is claim 1 which is presumed to describe the prior art,

11   not claims 3, 7, or 9. And although claim 1 is treated as prior art, it merely recites

12   that the target buffer is assigned by a process at a layer higher than the network

13   layer.

14   However, we have already determined above that a typical prior art multi-

15   layer protocol includes, in ascending order, the physical layer, the datalink layer,

16   the network layer, the transport layer, and the application layer. We have also

17   determined above based on Boucher's submissions that one with ordinary skill in

18   the art would have known that the transport layer of a multi-layer protocol can be

19   TCP, and that IP can be the network layer. Therefore, in light of claim 1's

20   specifying that the target buffer is assigned by a process higher than the network

21   layer, one with ordinary skill in the art would have readily recognized that the

22   target buffer can be assigned at the TCP layer or higher as it is recited in claim 19

23   or at a layer higher than the TCP layer as it is recited in claim 20.

1   For the foregoing reasons, Boucher has satisfied its burden of proof by a

2   preponderance of the evidence that Connery's claims 10-20 should be designated

3   as corresponding to Count 1. Specifically, Boucher has shown that despite the

4   differences between Connery's claim 1 presumed as prior art and each of

5   Connery's claims 10-20, the subject matter of each of Connery's claims 10-20

6   would have been obvious to one with ordinary skill in the art. Because

7   obviousness is a question of law, we do not rely on the ultimate legal conclusion of

8   obviousness from Boucher's witness Tal Lavian. Instead, we simply credit his

9   testimony with regard to what one with ordinary skill in the art would have known

10   about technical facts, none of which has been rebutted by a contrary opinion from

11   any Connery witness.

12   Boucher's Motion 3 is **granted**.

13   G.   Boucher's Motion 5
14   Correct Named inventorship
15
16   At the time of filing of Boucher's involved application on October 18, 2000,

17   it named six co-inventors Laurence B. Boucher ("L. B. Boucher"), Stephen E.

18   Blightman ("Blightman"), Peter K. Craft ("Craft"), David A. Higgen ("Higgen"),

19   Clive M. Philbrick ("Philbrick") and Daryl D. Starr ("Starr"). By this motion,

20   Boucher seeks to remove (1) L.B. Boucher, (2) Blightman, and (3) Starr as co-

21   inventors, leaving just Craft, Higgen, and Philbrick.

22   Because co-inventorship need not contribute to the subject matter of every

23   claim of a patent, inventorship is determined on a claim by claim basis. *Gemstar-*

24   *TV Guide v. International Trade Commission*, 383 F.3d 1352, 1381 (Fed. Cir.

1   2004). A joint inventor must contribute in some significant manner to conception

2   of the invention. *Fina Oil and Chemical Co. v. Ewen*, 123 F.3d 1466, 1473 (Fed.

3   Cir. 1997). As such, each inventor must contribute to the joint arrival at a definite

4   and permanent idea of the invention as it will be used in practice, but the basic

5   exercise of the normal skill expected of one with ordinary skill in the art without an

6   inventive act does not make one a joint inventor. *Id.*

7   Boucher as the moving party and applicant for patent bears the burden of

8   proof by a preponderance of the evidence. The named inventorship at the time of

9   declaration of this interference is presumptively correct. Therefore, Boucher must

10 demonstrate that (1) L.B. Boucher, (2) Blightman, and (3) Starr cannot be joint

11 inventors in Boucher's involved application which now includes only claims 41-

12 49, but need not start from scratch and demonstrate that (4) Craft, (5) Higgen, and

13 (6) Philbrick, who are already named as inventors, qualify as joint inventors.

14 While it is true that during a telephone conference call the patent judge managing

15 this interference indicated that Boucher must demonstrate the correctness of the

16 named inventorship it seeks, that indication is limited to situations in which

17 Boucher proposes to include additional inventors who are not already named. For

18 this motion which seeks to remove L.B. Boucher, Blightman, and Starr as named

19 inventors, it is sufficient that Boucher prove that the three individuals made no

20 inventive contribution to any one of Boucher's claims.

21   Of claims 41-49, claim 41 is the only independent claim. In his declaration,

22 L.B. Boucher testifies, with regard to independent claim 41, that the portion of

23 claim 41 prior to the determining step merely define a general environment that

1   was known to one with ordinary skill in the art. That is not disputed by Connery.

2   With regard to the remainder of claim 41, L.B. Boucher refers to it as two clauses:

3   determining based on the control field in the network interface
4   whether the packet matches a transmit control block (TCB),
5
6   and if so transferring the data payload in the packet directly to a target
7   buffer assigned by a process at a layer higher than the network layer.
8
9   L.B. Boucher testifies that the subject matter defined by the two clauses

10 reproduced above was jointly conceived by Philbrick, Higgen, and Craft (Exhibit

11 1014 ¶ 19), and that he did not contribute to the conception of the subject matter

12 defined by those two clauses. (Exhibit 1014 ¶ 25). However, other testimony of

13 L.B. Boucher casts substantial doubt on that averment, as is discussed below.

14   L.B. Boucher testifies that he, Blightman, Starr, Philbrick, and Craft jointly

15 conceived of subject matter defined by claim 29 of the parent application to

16 Boucher's involved application. (Exhibit 1014 ¶ 28). He further testifies that the

17 portion of claim 29 of the parent application prior to the categorizing step merely

18 define a general environment that was known to one with ordinary skill in the art,

19 and that the inventive step is represented by the following two clauses (Exhibit

20 1014 ¶ 29):

21   categorizing said packet with a hardware logic sequencer, including
22   classifying said headers and creating a summary of said packet, and
23
24   choosing, based upon said summary, whether to send said packet to
25   said stack of protocol layers or to bypass said stack of protocol layers
26   by sending said data to said destination.
27

1   With regard to those two clauses, L.B. Boucher testifies that Blightman,

2   Starr, and Philbrick each contributed to the conception of the subject matter

3   defined by the categorizing clause but that he jointly conceived with Philbrick,

4   Blightman, Starr, and Craft the subject matter of the choosing clause. (Exhibit

5   1014 ¶¶ 30-31).

6   L.B. Boucher testifies that he, Blightman, Starr, Philbrick, and Craft jointly

7   conceived of subject matter defined by claim 1 as originally filed with Boucher's

8   involved application. (Exhibit 1014 ¶ 9). He further testifies that the portion of

9   original claim 1 prior to the processing step merely define a general environment

10   that was known to one with ordinary skill in the art, and that the inventive step is

11   represented by the following two clauses (Exhibit 1014 ¶ 10):

12   processing said plurality of header layers with hardware circuitry,
13   including creating an indication of whether said packet is a candidate
14   for a fast-path transfer of said data to a destination in said host, and
15
16   choosing, including referencing said indication, whether to process
17   said packet by the protocol layers or to transfer said data according to
18   said fast-path without processing said packet by the protocol layers.
19

20   With regard to the two clauses quoted above, L.B. Boucher testifies that he

21   jointly conceived the subject matter of those two clauses together with Philbrick,

22   Blightman, Starr, and Craft. (Exhibit 1014 ¶ 11). He further states (Exhibit 1014

23   ¶ 13): "I had the basic idea of performing more, but not all, TCP processing on a

24   network interface card, but I did not know how to accomplish that goal."

25   Given L.B. Boucher's acknowledgment of inventive contribution to the last

26   two clauses in claim 1 of Boucher's involved application and to the last clause of

1   claim 29 of the parent application, and given his testimony that he conceived of the

2   idea of performing more TCP processing on a network interface card but just did

3   not know how to accomplish that goal, his testimony that he did not contribute to

4   the last two clauses of claim 41 is unpersuasive for lack of adequate explanation.

5   It is unexplained how L.B. Boucher could have contributed to the conception

6   of the features reflected in the last two clauses of originally filed claim 1 and the

7   last clause in claim 29 of the parent application and yet not have contributed to the

8   conception of the last two clauses of claim 41. It appears that the last two clauses

9   of claim 41 is narrower in that they require the use of a transfer control block. We

10   note also that L.B. Boucher distances himself from the concept of using a transfer

11   control block. For instance, he states on cross-examination (Exhibit 1045 90:3-9):

12   Well, once again, because of the high level, it is talking about
13   processing the data as it comes in. And I was associated with that.
14   But as soon as it gets to comparing it to the CCB, I was not associated
15   with that. So, you know, it is – the way this thing is split up is making
16   it difficult in terms of exactly what I was associated with and what I
17   wasn't.
18

19   He further states (Exhibit 1045 90:17-19): "The CCB and exactly how to make the

20   determination with the CCB I did not invent."

21   It appears the witness L.B. Boucher was confused and likely thought that

22   because he did not come up with the implementation of comparing data with a

23   transfer control block, he cannot be a joint inventor in connection with any claim

24   feature which makes use of a transfer control block. That is not true. He testified

25   that he came up with the general idea of performing more processing on the

26   network interface card but did not know how to accomplish that goal. If other

1   inventors built on that broad concept and came up with an implementation which

2   uses a transfer control block for data comparison, that does not eliminate L.B.

3   Boucher's significant underlying inventive contribution.

4   With regard to removing L.B. Boucher as a named inventor, Boucher has not

5   carried its burden of proof.

6   The assertion that Starr and Blightman should be removed as named

7   inventors is also unpersuasive. Starr testifies that he jointly conceived with L.B.

8   Boucher, Blightman, Philbrick, and Craft the subject matter of claim 1 of

9   Boucher's involved application. (Exhibit 1019 ¶ 7). Blightman testifies that he

10   jointly conceived with L.B. Boucher, Starr, Philbrick, and Craft the subject matter

11   of claim 1 of Boucher's involved application. (Exhibit 1015 ¶ 7). Starr and

12   Blightman each testify that he contributed to the conception of the following two

13   clauses in claim 1 of Boucher's involved application (Exhibit 1015 ¶ 12) (Exhibit

14   1019 ¶ 12):

15   processing said plurality of head layers with hardware circuitry,
16   including creating an indication of whether said packet is a candidate
17   for a fast-path transfer of said data to a destination in said host, and
18
19   choosing, including referencing said indication, whether to process
20   said packet by the protocol layers or to transfer said data according to
21   said fast-path without processing said packet by the protocol layers.
22
23   As is the case with L.B. Boucher, it is insufficiently explained how each of

24   Starr and Blightman contributed to the conception of the last two clauses of claim

25   1 but not contributed to the conception of the last two clauses of claim 41. The

1 features overlap and Boucher simply has not provided an adequate accounting in

2 sufficient detail to explain joint inventorship for claim 1 but not claim 41.

3   Boucher's Motion 5 is **denied**.

4   Connery submits that if we deny Boucher's Motion 5, we should enter

5 adverse judgment against Boucher for misnamed inventorship. We decline to do

6 so. It is not our conclusion that the named inventorship of Boucher is incorrect.

7 H.   Boucher's Motions 1 and 4
8   Asserting Unpatenbtability of Connery Claims 1-20
9

10   By Motion 1, Boucher asserts that Connery's claims 1-9 are unpatentable

11 under 35 U.S.C. § 102(e) over Boucher's provisional application 60/061,809.

12   By Motion 4, which is contingent on the granting of Motion 3 to designate

13 Connery's claims 10-20 as corresponding to Count 2, Boucher asserts that those

14 claims are unpatentable under 35 U.S.C. § 102(e) over Boucher's provisional

15 application 60/061,809.

16   Both Boucher's Motions 1 and 4 are **denied**.

17   Boucher submitted its list of proposed motions on November 12, 2010.

18 (Paper 18). In Items 1 and 8 of the list, Boucher requested to file a motion alleging

19 unpatentability of Connery's claims 1-20 as anticipated by Boucher's Provisional

20 Application 60/061,809 and also Boucher's Patent 6,226,680. The former was

21 incorporated by reference into the latter. During a telephone conference call

22 conducted on November 18, 2010, the patent judge inquired about Boucher's need

23 to file a motion for anticipation based on the provisional application 60/061,809

24 and a motion for anticipation based on Patent 6,226,680. In the order issued

1   subsequent to the conference call (Paper 19), dated November 22, 2010, the patent

2   judge authorized only a motion alleging anticipation based on provisional

3   application 60/061,809, not a motion alleging anticipation based on Patent

4   6,226,680. However, the patent judge gave Boucher the option to switch the basis

5   to Patent 6,226,680, exercisable by initiating a telephone conference call with the

6   patent judge to discuss the switch.

7   Boucher never exercised the option provided by the patent judge. On

8   January 18, 2011, Boucher filed Motion 1 alleging unpatentability of claims 1-9

9   for anticipation based on provisional application 60/061,809, and also Motion 4, in

10   case claims 10-20 are designated as corresponding to a count in this interference

11   per Boucher's Motion 3, alleging unpatentability of Connery's claims 10-20 for

12   anticipation based on provisional application 60/061,809. The option to switch to

13   Patent 6,226,680 as the basis of the anticipation assertion naturally expired on

14   January 18, 2011, when Boucher filed its Motions 1 and 4 based on provisional

15   application 60/061,809.

16   In Motion 1, Boucher attempts to qualify provisional application 60/061,809

17   as prior art as follows (Motion 1 at 8:5-10):

18   1.   Availability of Boucher '809 under 35 USC 102(e)
19
20   Boucher '809 was filed October 14, 1997. MF (70). It was
21   relied upon for priority and incorporated by reference in the
22   application that matured into Boucher '680. MF (71). That
23   application was filed on April 27, 1998 and matured into Boucher
24   '680 on May 1, 2001. MF (72). Connery was filed on May 1, 1998.
25   MF (73). Boucher '809 is therefore available as prior art to Connery
26   under 35 USC 102(e). MF (74).
27

1   In Motion 4, Boucher attempts to qualify provisional application 60/061,809

2 as prior art as follows (Motion 4 at 9:4-10):

3   1.   Availability of Boucher '809 under 35 USC 102(e)
4
5   Boucher '809 was filed October 14, 1997. MF (92). It was
6   relied upon for priority and incorporated by reference in the
7   application that matured into Boucher '680. MF (93). That
8   application was filed on April 27, 1998 and matured into Boucher
9   '680 on May 1, 2001. MF (94).
10
11   Connery was filed on May 1, 1998. MF (95).
12
13   Boucher '809 is therefore available as prior art to Connery under 35
14   USC 102(e).
15

16   The above-quoted rationale sets forth only that Patent 6,226,680 qualifies as

17 prior art, not provisional application 60/061,809. It does not appear that

18 provisional application 60/061,809 was converted into a non-provisional

19 application which later issued as a patent and Boucher does not represent that it

20 was. The current status of provisional application 60/061,809 is that it is

21 abandoned.

22   Thus, Boucher has not demonstrated that provisional application 60/061,809

23 constitutes applicable prior art. For that reason, Boucher's Motions 1 and 4 are

24 both denied.

25   In the alternative, even assuming that provisional application 60/061,809

26 constitutes applicable prior art, Boucher has not satisfied its burden of proof on the

27 merits for either Motion 1 or Motion 4 and thus Motions 1 and 4 are nonetheless

28 still denied.

1   A finding of anticipation requires that each and every element, arranged in a

2   combination precisely as is recited in the claim, must be found in a single prior art

3   reference. *Karsten Manufacturing Corp.*, 242 F.3d at 1383. Connery's claim 1 is

4   an independent claim and claims 2-9 depends directly or indirectly from claim 1.

5   One of the steps expressly recited in method claim 1 is:

6   **determining** based on the control field in the network interface
7   **whether the packet matches a flow specification**, (emphasis added.)
8
9   We have already interpreted "flow specification" in the context of Connery's

10 specification as "information identifying a block of data for transfer" and noted

11 that in Connery's specification a preferred embodiment of the flow specification

12 includes a range of sequence numbers for the block of data, such as a starting

13 number and a length number. (Exhibit 2009, 2:48-56). These two numbers

14 together identify the block of data for transfer by revealing all the sequence

15 numbers of data within the block. Nevertheless, we indicated that any way of

16 identifying the block of data would suffice, as the range of sequence numbers

17 , disclosed in Connery's specification only constitute a preferred embodiment. We

18 noted that further description in Connery's specification (Exhibit 2009, 2:18-19)

19 confirms that "flow specification" is a general construct and covers whatever that

20 can be used to specifically identify a block of data for transfer: "The flow

21 specification specifies how to identify packets that are part of this session."

22   We reject Boucher's interpretation of "flow specification" in Connery's

23 claims as meaning a description of network data flow, such as a set of source and

24 destination network layer addresses and source and destination transport layer

25 ports.

1   For reasons discussed above, it is clear that Connery's flow specification is tied to

2   identification of a specific block of data being transferred. While a flow

3   specification may include source and destination network addresses of data packets

4   and port or socket numbers of the transport layer, that information is not what

5   identifies a block of data for transfer and thus forming a flow specification. In that

6   regard, Boucher is in agreement that claim 1 requires neither source and

7   destination addresses nor port numbers. (Motion 6:25-26).

8   Boucher points to Connery's Abstract and asserts that a sentence in the

9   Abstract suggests that a flow specification is something found in the received

10   packets. The assertion is unpersuasive. The purpose of an Abstract is typically to

11   provide a summary of the technical disclosure in the specification. Boucher has

12   identified nothing from elsewhere in the specification which indicates that the flow

13   specification is found or provided in the received packets. To the contrary, the

14   specification clearly indicates that the flow specification is provided by the data

15   request and the protocol stack or suite executing on the host system requesting the

16   data. (Exhibit 2009 1:22-26; 2:39-41). Boucher has not identified any instance in

17   Connery's specification where information from each received packet is compared

18   with other information received from the same packet and identifying a block of

19   data for transfer to determine whether data from the packet should be stored

20   directly into a target buffer.

21   There is a much more reasonable alternative reading of the Abstract. From

22   the perspective of one with ordinary skill and in the context of Connery's

23   specification, in the sentence "[t]he network interface device identifies the packets

24   which are in the sequence of packets carrying payload to be stored in the target

1 buffer by the flow specification carried with such packets," the reference to "flow

2 specification carried with such packets" means information which are used for

3 comparison with the flow specification, not literally the flow specification itself.

4   In any event, whether or not the flow specification is contained in the

5 received packet does not eliminate the requirement that it must specifically identify

6 a block of data for transfer. Boucher has not explained where in the disclosure of

7 its provisional application is description of information contained in each packet

8 received, which identifies a block of data for transfer.

9   Given that a flow specification means information identifying a block of

10 data for transfer, the step of determining whether a received packet matches a flow

11 specification means, based on the broadest reasonable construction in light of the

12 specification, determining whether the received packet is from within the identified

13 block of data. In that regard, Boucher has articulated no alternative meaning which

14 accounts for the required characteristic – that the "flow specification" must

15 specifically identify a block of data for transfer.

16   Accordingly, to establish a case of anticipation for any one of Connery's

17 claims 1-9, Boucher must demonstrate disclosure in its provisional application

18 60/061,809 which describes determining in the network interface, based on control

19 field in a received packet, whether the packet belongs within a specifically

20 identified block of data. That, Boucher has not done. Boucher has not pointed out

21 where in its provisional application 60/061,809 is disclosure of information

22 identifying a block of data for transfer, and where in its provisional application

23 60/061,809 is disclosure for comparing control field of a received packet with the

1   information identifying a block of data for transfer to see if the received packet

2   comes from within the identified block of data.

3   Independent claim 10 has similar claim limitations regarding a flow

4   specification and determining whether a packet falls within the flow specification.

5   Claim 10 recites:

6   . . . packets in the plurality of packets including control fields
7   identifying whether the packet falls within the flow specification of
8   the block of data,
9
10   upon receiving a packet, determining in the network interface whether
11   the packet falls within the flow specification,
12
13   Claim 16 similarly recites:

14   upon receiving each packet, determining in the network interface
15   whether the packet falls within the flow specification,
16
17   To establish a case of anticipation for any one of Connery's claims 10-20,

18   Boucher must demonstrate disclosure in its provisional application 60/061,809

19   which describes determining in the network interface, when a packet has been

20   received, whether the packet falls within a specifically identified block of data

21   constituting a flow specification. That, Boucher has not done.

22   Claims 11-15 depend directly or indirectly from claim 10 and claims 17-20

23   depend directly or indirectly from claim 16. The dependent claims each include all

24   the features of the independent claim on which it depends.

25   For the foregoing reasons, Boucher has not met its burden of proof in

26   establishing anticipation of any one of Connery's claims 1-20 based on Boucher's

1 provisional application 60/061,809, even assuming the provisional application is

2 applicable prior art.

3 I.   Boucher's Motion 6 to Exclude Evidence

4

5   Boucher seeks to exclude as inadmissible Connery's Exhibits 2047 and

6 2048.

7 <div align="center">Connery's Exhibit 2047</div>

8   Connery's Exhibit 2047 is relied on by Connery in its Reply 1. It is

9 represented by Connery as a written transcript prepared by an independent court

10 reporting company of an audio recording provided by Boucher of a discussion in a

11 confidential meeting between Boucher's inventors on the topic of conception dates,

12 in which the inventors also discussed the invention of Connery's involved patent.

13 The audio recording itself is in the record of this interference both as Boucher's

14 Exhibit 1022 and Connery's Exhibit 2052. In the record of this interference is also

15 Boucher's own transcription (Exhibit 1058 (Ex. B)) of the audio recording.

16   The basis for Boucher's request to exclude Connery's Exhibit 2047 is that

17 according to Boucher the transcription that is Connery's Exhibit 2047 contains

18 numerous errors. In the motion to exclude, Boucher identified no less than twenty

19 (20) instances where it believes that according to the audio recording that is

20 Exhibit 1022 or Exhibit 2052 the speaker stated one thing and the transcription by

21 Connery's incorrectly states something else.

22   Connery's Motion 1 has been denied, even without excluding Connery's

23 Exhibit 2047. Therefore, the issue is moot on whether the exhibit should be

24 excluded. On that basis, with respect to Exhibit 2047, the motion is **dismissed.**

1   Alternatively, with respect to Exhibit 2047 and for reasons discussed below,

2   the motion is **denied**.

3   Alleged inaccuracy in a transcription is not sufficient grounds to exclude the

4   transcription where, as here, the party asserting the inaccuracies has prepared and

5   submitted its own competing transcription and has had an opportunity to point out

6   the inaccuracies it believes are contained in the opponent's transcription. The case

7   for exclusion is even far less persuasive where, as here, the transcription is of an

8   audio recording and the audio recording itself has been submitted by each party,

9   separately, as an Exhibit, *i.e.*, Exhibit 1022 and Exhibit 2052. Where the parties

10   dispute with regard to particular instances of transcription, we rely on neither

11   party's transcription but on the underlying audio recording that is in the record.

12   All but two of Boucher's identification of incorrect transcription of the audio

13   recording appear to have merit. With regard to the alleged substitution of the word

14   "parameter" for "frame" at location 33:40 and elsewhere, we find no

15   corresponding support in the referenced portions of the audio recording. Also, at

16   location 33:32, we hear "receive issue" rather than "receive direction" as urged by

17   Boucher. Furthermore, on page 4, in lines 7-11 of the motion, Boucher asserts

18   certain errors on pages 36-38 of Exhibit 2047 but fails to identify the alleged

19   errors. We decline to take on the initial task of researching the competing

20   transcripts for differences. Despite the inaccuracies noted by Boucher, for reasons

21   stated above we see no reason to exclude Exhibit 2047.

22   We have considered Exhibit 2047 and find that it has little value in

23   supporting Connery's Motion 1. What Boucher's inventors thought of the

24   workings of Connery's invention does not help to construe "flow specification" in

1   Connery's claims, as it is entirely unclear whether they were discussing the

2   technical disclosure in the specification as preferred embodiments or what a "flow

3   specification" in the context of Connery's specification necessarily must include.

4   It is also not clear whether they were speaking from the perspective of one with

5   ordinary skill in the art. They were also not speaking under oath or declaration and

6   so the statements cannot be considered as testimony. In any event, we do not defer

7   to Boucher's inventors on the legal question of claim interpretation.

8   Connery's Exhibit 2048

9   Connery's Exhibit 2048 is relied on by Connery in its Reply 1. It is

10   represented by Connery as a redacted letter from one of Connery's patent attorneys

11   to one of the named inventors on the Connery patent. Boucher's statement of

12   objection (Exhibit 1058) to that Exhibit is as follows:

13   **Exhibit 2048** – Letter from M. Haynes to Connery dated Jan. 23,
14   1998 (Redacted).
15
16   Boucher objects to Connery Exhibit 2048 under Rule 106 of the
17   Federal Rules of Evidence on the ground that it is a redacted portion
18   of a writing, and that, in fairness, all other parts of the same document
19   ought to be considered contemporaneously with it. See generally
20   Gholz, How to Redact an Exhibit for Use in an Interference, 11
21   Intellectual Property Today No. 11 (2004) at page 16.
22
23   Boucher further objects to Exhibit 2048 under Rule 901 of the
24   Federal Rules of Evidence on the ground that the writing is not
25   authenticated.
26
27   As a purported letter from counsel to client, Exhibit 2048 is without

28   authentication. In opposition to Boucher's motion to exclude, Connery does not

1   point to any testimony of Mark A. Haynes, the counsel who supposedly authored

2   and sent the letter, or of Glenn W. Connery, the inventor who supposedly received

3   the letter, which authenticates the letter for what it is purported to be. Similarly,

4   Connery also has not pointed to the testimony of any other witness who is familiar

5   either with writing of the letter by Mark A. Haynes or receiving of the letter by

6   Glenn W. Connery. On this record, Exhibit 2048 is without authentication.

7   Subsequent to the early objection by Boucher prior to filing of the motion to

8   exclude, Connery had opportunity to provide authenticating testimony but chose

9   not to do so. In its opposition to Boucher's motion to exclude, Connery does not

10   take the position that the letter is properly authenticated. Instead, Connery states

11   that the issue of authentication may be moot because if the Board excludes

12   Boucher's Exhibit 2029 then Connery would agree that its Exhibit 2048 is

13   unnecessary.

14   Whether Connery believes it needs to rely on Exhibit 2048 has no bearing on

15   whether it has authenticated the exhibit as a letter from counsel to inventor. For

16   reasons discussed above, on the ground of failing to make proper authentication,

17   Boucher's motion to exclude Connery's Exhibit 2048 is **granted.**

18   We decline to exclude Exhibit 2048 on the ground of its having omitted

19   portions of the same document. Connery's offer to make an unredacted copy of

20   Exhibit 2048 available for *in camara* review by the patent judge to ensure that

21   Boucher would not be prejudiced by Connery's redaction of materials was an

22   acceptable way of handling that issue. However, Boucher did not follow up on

23   Connery's reasonable offer by timely contacting the patent judge and thus is

24   regarded as having waived all issues with regard to redactions in Exhibit 2048.

1   J.   Connery's Motion 5 to Exclude Evidence

2   Exhibit 1003

3   Exhibit 1003 is a declaration of Boucher's technical witness Tal Lavian.

4   Connery seeks to exclude the following paragraphs in Tal Lavian's declaration:

5   82-86, 88, 115, 240-242, 287-291, 357, 361-362, 368, 369, and 405.

6   Paragraph Nos. 82-86, 88, and 115 were relied upon by Boucher in

7   Boucher's Motion 1. Paragraph Nos. 240-242 were relied upon by Boucher in

8   Boucher's Motion 2. Paragraph 405 was relied upon by Boucher in Boucher's

9   Motion 4. Boucher's Motions 1, 2, and 4, however, have all been denied even

10   without excluding Paragraph Nos. 82-86, 88, 115, 240-242, and 405 of Exhibit

11   1003. Accordingly, the issue of exclusion with respect to those paragraphs is

12   moot.

13   Paragraph Nos. 287-291, 357, 361, 362, 368, and 369 were relied upon by

14   Boucher in Boucher's Motion 3. Connery's stated reason for excluding those

15   paragraphs is that they were relied on in support of Boucher's argument that

16   Connery's claims are indefinite under 35 U.S.C. § 112, second paragraph, although

17   Boucher had not been authorized to attack Connery's claims as indefinite.

18   In granting Boucher's Motion 3, we did not hold any Connery claim as

19   indefinite under 35 U.S.C. § 112, second paragraph. Moreover, we specifically

20   stated that Boucher had not been authorized to attack Connery's claims as

21   indefinite and that we decline to entertain the argument. Accordingly, the issue of

22   exclusion with respect to Paragraph Nos. 287-291, 357, 361, 362, 368, and 369 is

23   moot.

24

1   Exhibit 1013

2   Exhibit 1013 is a declaration of Boucher's patent attorney Mark A. Lauer.

3   Connery seeks to exclude the entirety of the declaration because in connection with

4   Boucher's Motion 5 Boucher offered and relied on the declaration to show the

5   inventive contribution of each originally named inventor on Boucher's involved

6   application and to give Mr. Lauer's opinion as to the proper inventorship.

7   It cannot be reasonably disputed that on this record Mark Lauer has no

8   personal knowledge of the inventive contribution of any of the original named-

9   inventors on Boucher's involved application. His testimony in that regard merely

10   states what he was told by each named-inventor. In that connection, the testimony

11   is inadmissible hearsay offered to show the truth of the matter asserted. We reject

12   Boucher's assertion that Mark Lauer's subjective belief constitutes personal

13   knowledge. As for Mark Lauer's opinion on proper inventorship, the opinion is on

14   a legal question and not helpful to the Board for determining any fact at issue. It

15   does not qualify for admission as expert opinion under Fed. R. Evid. 702;

16   Bd.R. 158(a).

17   In Boucher's Motion 5, it is asserted that Mark Laurer's testimony is

18   admissible to prove lack of deceptive intent. However, what matters for correcting

19   misnamed inventorship is the lack of deceptive intent on the part of each original

20   named-inventor to be removed and of each inventor to be added, not of Mark

21   Lauer as patent attorney. It is also not evident from Boucher's Motion 5 that Mark

22   Lauer's testimony was submitted to show lack of deceptive intent on the part of

23   anyone.

24   Exhibit 1013 is inadmissible.

1   Exhibits 1014-1019

2   Exhibits 1014-1019 were relied on by Boucher in connection with Boucher's

3   Motion 5 and/or Reply 5. Boucher's Motion 5 seeks to change the originally

4   named inventorship. Exhibit 1014 is a declaration from named inventor L.B.

5   Boucher; Exhibit 1015 is a declaration from named inventor Stephen E.

6   Blightman; Exhibit 1016 is a declaration from named inventor Peter K. Craft;

7   Exhibit 1017 is a declaration from named inventor David A. Higgen; Exhibit 1018

8   is a declaration from named inventor Clive M. Philbrick; and Exhibit 1019 is a

9   declaration from named inventor Daryl D. Starr. Connery seeks to exclude certain

10 paragraphs from the declaration of each of the named inventors.

11   We have denied Boucher's Motion 5 even without excluding any testimony

12 from L.B. Boucher, Blightman, Craft, Higgen, Philbrick, and Starr. Accordingly,

13 with respect to Exhibits 1014-1019, Connery's Motion 5 to exclude is moot.

14   Exhibit 1052

15   Exhibit 1052 is the Fourth Declaration of Tal Lavian as Boucher's technical

16 witness. Connery seeks to exclude Paragraph Nos. 28, 88, and 197 of that

17 declaration. Paragraph Nos. 28 and 88 were relied on by Boucher in Boucher's

18 Reply 1. Paragraph 197 was relied on by Boucher in Boucher's Reply 5.

19   We have denied both Boucher's Motion 1 and Motion 5 even without

20 excluding any testimony from Exhibit 1052. Accordingly, with respect to Exhibit

21 1052, Connery's Motion 5 to exclude evidence is moot.

1   Exhibit 1053

2   Exhibit 1053 is the Second Declaration of David Higgen, a named inventor

3   on Boucher's involved application. Connery seeks to exclude Paragraph No. 5 of

4   that declaration. Paragraph No. 5 was relied on by Boucher in Boucher's Reply 5.

5   We have denied Boucher's Motion 5 even without excluding any testimony

6   from Exhibit 1053. Accordingly, with respect to Exhibit 1053, Connery's Motion

7   5 to exclude evidence is moot.

8   Exhibit 1054

9   Exhibit 1054 is a declaration of James Cihla. Connery seeks to exclude

10   Paragraph Nos. 3-5 of that declaration. Paragraph Nos. 3-5 were relied on by

11   Boucher in Boucher's Reply 5.

12   We have denied Boucher's Motion 5 even without excluding any testimony

13   from Exhibit 1054. Accordingly, with respect to Exhibit 1054, Connery's Motion

14   5 to exclude evidence is moot.

15   In summary, Connery's Motion 5 is **granted** with respect to Exhibit 1013,

16   the declaration of Mark Lauer, and is otherwise **dismissed.**

17   **Conclusion**

18   Connery's Motion 1 alleging no interference-in-fact is *denied.*

19   Connery's Motion 2 alleging unpatentability of Boucher's claims for lack of

20   written description under 35 U.S.C. § 112, first paragraph, is *granted* with regard

21   to Boucher's claims 46-49 and *denied* with regard to Boucher's claims 41-45.

22   Connery's Motion 3 seeking to deny Boucher previously accorded benefit

23   dates with respect to Counts 1 and 2 is *denied.*

24   Connery's Motion 5 to exclude evidence is *granted-in-part.*

1   Boucher's Motions 1 alleging unpatentability of Connery's claims 1-9 as

2   anticipated by prior art under 35 U.S.C. § 102(e) is *denied*.

3   Boucher's Motion 2 seeking to combine Counts 1 and 2 is *denied*.

4   Boucher's Motion 3 seeking to designate Connery's claims 10-20 as

5   corresponding to Count 1 is *granted*.

6   Boucher's Motions 4 alleging unpatentability of Connery's claims 10-20 as

7   anticipated by prior art under 35 U.S.C. § 102(e) is *denied*.

8   Boucher's Motion 5 seeking to correct its named inventorship by eliminating

9   Stephen E. Blightman, L.B. Boucher, and Daryl D. Starr as co-inventors is *denied*.

10   Boucher's Motion 6 to exclude evidence is *granted-in-part*.

11

12   TORCZON, *Administrative Patent Judge*, concurring.

13   I join in the majority's thorough opinion, but write separately to address

14   concerns about some of the alternative bases expressed in the decision.

15   INDEFINITENESS

16   Whether a lack of antecedent basis renders a claim indefinite must be

17   determined in the context of a specific claim. The cited cases from the 1970s

18   describe a relatively liberal approach to claim construction. More recently, both

19   the courts and the board have suggested that the standard should be higher when

20   the inventor has an opportunity to amend the claim. *Ex parte Miyazaki*, 89

21   USPQ2d 1207, 1212 (BPAI 2008), *citing Exxon Res. & Eng'g Co. v. United States*,

22   265 F.3d 1371, 1384 (Fed. Cir. 2001) ("If this case were before an examiner, the

23   examiner might well be justified in demanding that the applicant more clearly

24   define UL, and thereby remove any degree of ambiguity. However, we are faced

1 with an issued patent that enjoys a presumption of validity."), *and cited with*

2 *approval in Enzo Biochem Inc. v. Applera Corp.*, 605 F.3d 1347, 1349 (Fed. Cir.

3 2010) (Plager, dissenting from denial of en banc petition). This nuanced shift may

4 reflect frustration with the decline in clarity (and subsequent frustration of the

5 notice function of claims) that has resulted from the older practice.

6   The critical factor in this case is Boucher's decision not to move separately

7 for a decision on the definiteness of Connery's claim, which obscured the question

8 of whether Connery should amend its claim (via a responsive motion and a reissue

9 application). Connery's reaction (to request such relief or not) would have helped

10 to clarify the issue and preserve due process for both parties.

11   Similarly (and independently of whether it is binding precedent) *Fritsch v.*

12 *Lin* should not be read to create a per se rule for indefinite claims. As a matter of

13 law, the *Fritsch* panel expressly based its determination on agency rules and

14 guidance that no longer exist. As a matter of practice, indefiniteness might or

15 might not affect what can be done with the claim. In an interference, all priority

16 issues (including claim correspondence) are based on 35 U.S.C. 102(g)(1). There

17 is ample case law for the proposition that when a claim cannot be construed, it

18 should be treated under 35 U.S.C. 112(2) rather than treated as broad for purposes

19 of § 102. *E.g., In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). On the other

20 hand, it is often possible to say with certainty that an anticipating embodiment is

21 within the scope of a claim without being able to define the outer bounds of the

22 claim with certainty. *Ex parte Tanksley*, 26 USPQ2d 1384, 1387 (BPAI 1991)

23 (holding claim too indefinite to determine anticipation, but sufficiently definite to

24 determine obviousness).

1   COPIED CLAIM

2   Are Boucher's claims "copied"? I don't know because I don't know what

3   "copied claim" means. There is no statutory or regulatory definition of "copied

4   claim". The case law assumes the term has meaning without analysis. Sometimes

5   claims are verbatim identical, which allows us to avoid the question entirely

6   (perhaps mistakenly, as I will discuss later).

7   In the present case, independent claim 41 is almost identical to Connery's

8   claim 1, but the difference is the crux of the dispute. Is claim 41 copied?

9   The simplest answer is "no, the claim is not copied" since there is a

10   difference. Indeed, in this case, the difference is central rather than peripheral to

11   the dispute. If so, the line of "copied claim" case law beginning with *In re Spina*,

12   975 F.2d 854, 856 (Fed. Cir. 1992), is irrelevant in this case (and in any case where

13   "copier" is wise enough to avoid this morass). Such a bright-line would be easy to

14   apply, but would reduce the *Spina* doctrine to a trap for the unwary? Certainly, an

15   exactly copied claim is not necessary to declare an interference, *Case v. CPC Int'l,*

16   *Inc.*, 730 F.2d 745, 749 (Fed. Cir. 1984) (superseded by statute on other grounds),

17   as the present case shows.

18   If we assume that mere drafting tricks are not sufficient to avoid the *Spina*

19   doctrine then we must engage in an analytically dubious exercise of line drawing:

20   when does a copied claim stop being "copied"? Would corrections to syntax or

21   punctuation suffice? What if the difference were in language that was not limiting

22   (for example, a non-limiting preamble). What if the difference were limiting, but

23   the limitation is acknowledge to be routine in the relevant art? What if, as here, the

24   difference is the crux of the dispute? What if the claim is drawn to exactly the

1 same invention, but carefully uses different words (apart from incidental articles

2 and prepositions)?

3   The cases themselves provide no useful guidance. *Spina* states that:

4   "When interpretation is required of a claim that is copied for
5   interference purposes, the copied claim is viewed in the context of the
6   patent from which it was copied. *DeGeorge v. Bernier*, 768 F.2d
7   1318, 1322, 226 USPQ 758, 761 (Fed. Cir. 1985) (if claim language is
8   ambiguous "resort must be had to the specification of the patent from
9   which the copied claim came").
10
11 The problem is two-fold. First, the statement assumes "copied" has a definite

12 meaning. Second, *DeGeorge* does not say "if claim language is ambiguous 'resort

13 must be had to the specification of the patent from which the copied claim came'".

14 *DeGeorge* is actually talking about a count, not a copied claim as the full quote

15 shows:

16   A critical issue, therefore, is *construction of the count*, a question of
17   law. Interference counts are given the broadest reasonable
18   interpretation possible, and resort to the specification is necessary
19   only when there are ambiguities inherent in the claim language or
20   obvious from arguments of counsel. If there is such ambiguity, *resort*
21   *must be had to the specification of the patent from which the copied*
22   *claim came.*
23
24 *DeGeorge*, 768 F.2d at 1321-22 (emphasis added, citations omitted). As the court

25 had earlier warned, it is a mistake to confuse claims and counts. *Case*, 730 F.2d

26 at 749 ("Case confuses 'claims' and 'counts' throughout his argument but never is

27 wider of the mark than here. The counts are not claims to an invention by either

28 party.").

1   In *DeGeorge*, the problem the court faced was that the count was verbatim

2   identical to an original claim of one party and an identically worded "copied" claim

3   of another party. Unlike a claim, however, the count has no corresponding

4   specification. Thus, when the count is ambiguous, there is no automatic reference

5   source for determining its meaning. The court resolved this dilemma by choosing

6   the specification of the original claim as the appropriate reference. This choice

7   was, like the mail-box rule in contracts or the side of the road for driving, not

8   based on some profound truth or moral judgment, but simply a recognition that

9   some choice was needed. Forced to choose for the purposes of *count construction*,

10   *DeGeorge* gave a slight advantage to the first party to use the precise language in a

11   claim, presumably assuming the copier knew what it was getting into.

12   Significantly, in *DeGeorge*, the court did not decide the written description of any

13   claim, although that is the issue for which *Spina* cites to it.[2] The *Spina* doctrine,

14   far from being a long-established, essential part of interference practice and theory,

15   first arose as a misreading of earlier case law.

16   The late-Chief Judge Howard Markey liked to ask "Why not the statute?"[3]

17   For written description, the statute is 35 U.S.C. 112, specifically the first

18   paragraph, which states:

---

2 The court does address a "right to make" issue in the case, but right to make was emphatically not the same as written description since the then-Board of Interferences had no authority to decide patentability issues. Unlike written description, for right to make the burden of persuasion rested on the claim copier rather than on the attacking opponent. The court determined that the board had erred in setting the burden too high. In *Koninklijke Philips Electronics N.V. v. Cardiac Science Operating Co.*, 590 F.3d 1326, 1337 (Fed. Cir. 2010), the court explained that the burden of proof issue is irrelevant to the written description question.

3 E.g., Markey, H., *Why Not the Statute?*, 65 J. Pat. Off. Soc'y 331 (1983).

1   The specification shall contain a written description of the invention,
2   and of the manner and process of making and using it, in such full,
3   clear, concise, and exact terms as to enable any person skilled in the
4   art to which it pertains, or with which it is most nearly connected, to
5   make and use the same, and shall set forth the best mode
6   contemplated by the inventor of carrying out his invention.
7
8   While the statute talks about "the specification", "the invention" and "the inventor",

9   thus implicitly tying all three together, it does not itself offer an express rule for

10   construing an ambiguous claim. The second and sixth paragraphs, however, offer

11   useful guidance:

12   [2] The specification shall conclude with one or more claims
13   particularly pointing out and distinctly claiming the subject matter
14   which the applicant regards as his invention.
15
16   [6] An element in a claim for a combination may be expressed as a
17   means or step for performing a specified function without the recital
18   of structure, material, or acts in support thereof, and such claim shall
19   be construed to cover the corresponding structure, material, or acts
20   described in the specification and equivalents thereof.
21
22   The provisions show that the claim is tied to its specification and, in the case of

23   paragraph 6, expressly requires reliance on the specification as the source of

24   meaning. Neither *Spina* nor its progeny address these statutory mandates. The

25   problem becomes stark for a means-plus-function limitation.

26   Imagine that the common invention required two substrates to be fastened

27   together, with one specification teaching the use of adhesive and the other

28   specification teaching the use of a rivet. Under standard claim construction,

29   "means for fastening" would be construed to cover, respectively, either adhesives

1   and their equivalents or rivets and their equivalents. Each construction would be

2   supported by the corresponding specification. The question would then become

3   one of interference-in-fact: for this invention, are adhesion and riveting patentably

4   distinct or not?

5   Under *Spina*,[4] however, resort would be made to the specification of the first

6   inventor to use the means language, which disclosed, for example, adhesive.

7   Having construed the "copied" claim to require adhesive or its equivalent, one

8   would then search the copier's specification to determine whether the use of an

9   adhesive or its equivalent. Since a rivet is not likely to be structurally equivalent to

10   an adhesive, the copier would be held to lack supporting written description, even

11   though in every non-interference context the same claim would be consider to have

12   support (in the rivet disclosure) as a matter of statutory law.

13   Similar problems abound throughout patent law. In *Rowe v. Dror*, 112 F.3d

14   473, 479 (Fed. Cir. 1997), the court held that a "copied" claim is construed in terms

15   of its own specification for all other patentability determinations. But what if the

16   problem is intervening prior art? Benefit and priority statutes (e.g., 35 U.S.C. 119

17   and 120) require resort to § 112(1) to see if the claimed subject matter antedates

18   the reference. So does the *Spina* doctrine apply to the benefit determination or

19   not? If so, the copied claim would mean one thing for the application of the prior

20   art (e.g., means = rivet) and a different thing for benefit (e.g., means = adhesive).

---

4 Unlike this hypothetical, in *Spina*, the court held that " Barron did not provide significantly different support for this clause than does Spina." 975 F.2d at 857. Arguably, this made the *Spina* doctrine mere dictum in *Spina* itself since the corresponding structure had the same meaning regardless of which specification was considered.

1   If the *Spina* doctrine does not apply to the benefit analysis, then what theory would

2   justify the difference?

3   In *Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328, 1332 (Fed. Cir.

4   2000) ("Every patent claim is construed in the context of the specification in which

5   it appears as part of the patent document."), the court declined to extend the *Spina*

6   doctrine to an invalidity determination. This distinction drives to the heart of

7   patent law. The claim under review for invalidity (e.g., means = rivet) has never

8   been examined since, under the *Spina* doctrine, the examiner was obligated to

9   examine a different claim (i.e., means = adhesive) despite what its host

10 specification said. Can the fact that the examiner must examine a different claim

11 than the claim that will be enforced be reconciled with a presumption of validity

12 under 35 U.S.C. 282?[5] Moreover, § 282 bases the invalidity defense "on any

13 ground specified in part II of this title as a condition of patentability". Thus, if the

14 *Spina* doctrine is right, *Cultor Corp.* must have been wrongly decided because

15 invalidity of a "copied" claim must be based on the patentability for the "copied"

16 claim.

17   *Philips* offers a possible clue to why the court cleaves to the *Spina* doctrine.

18 In *Philips*, the court insists on the continuing relevance of the old "right to make"

19 cases, specifically *Squires v. Corbett*, 560 F.2d 424, 434 (CCPA 1977), *cited*

20 *at* 590 F.3d at 1337. *Squires*, in turn, explains that right to make is necessary

21 because otherwise the copier:

---

5 While examiners use a different (broader) scope of construction during examination, the examined claim is the
same. The broader scope does not result in no examination of the claim, but if anything an over-examination of the
claim, consistent with the resulting certainty underlying the statutory presumption of validity.

1   has been allowed to copy exactly Squires' patent claim with less than
2   adequate supporting disclosure...rather than having been required to
3   properly copy the claim in modified form, then Squires has been
4   unfairly precluded from raising the issue of interference in fact by
5   operation of 37 CFR 1.231(a)(1)."
6

7 It appears that the court thinks the old right to make practice and thus the *Spina*

8 doctrine are necessary to permit a party to contest no interference-in-fact. Old

9 Rule 231(a)(1) (1977) stated in relevant part:

10   A motion to dissolve on the ground that there is no interference in fact
11   will not be considered unless the interference involves a design or
12   plant patent or application or unless it relates to a count which differs
13   from the corresponding claim of an involved patent or of one or more
14   of the involved applications as provided in §§ 1.203(a) and 1.205(a).
15

16 Rules 203(a) and 205(a) had similar provisions for provoking an interference with

17 an application and patent, respectively. For example, Rule 205(a) provided:

18   Before an interference will be declared with a patent, the applicant
19   must present in his application, copies of all of the claims of the patent
20   which also define his invention and such claims must be patentable in
21   the application. However, an interference may be declared after
22   copying the claims excluding an immaterial limitation or variation if
23   such immaterial limitation or variation is not clearly supported in the
24   application or if the applicant otherwise makes a satisfactory showing
25   in justification thereof.
26

27 As the *Squires* court understood the practice, if a claim were "exactly"[6] copied, the

28 patentee could not move for judgment of no interference-in-fact.

---

6 If the *Spina* doctrine really does derive from the problem in *Squires*, then to the extent it is not obsolete, perhaps it should be limited to cases where the claim is exactly copied; in which case, patent practitioners should think long and hard before counseling a client to copy a claim.

1   The rules that troubled the *Squires* court have not existed since 1985. The

2 Office has not required an applicant seeking an interference to copy a claim in

3 order to provoke the interference since 1985. To the best of my knowledge, no

4 "right to make" challenge has been filed in an interference declared since 1985,

5 certainly not in the last two decades. Nevertheless, the board routinely decides

6 questions of no interference-in-fact. *E.g.*, *Eli Lilly & Co. v. Bd. of Regents of the*

7 *Univ. of Wa.*, 334 F.3d 1264 (Fed. Cir. 2003). The concepts that the court appears

8 to assume are essential to fair interference practice are, in fact, obsolete in view of

9 statutory and regulatory changes that occurred a generation ago.

10   The problem appears to be that private litigants do not always appreciate the

11 legal significance of an administrative practice or else do not have the incentives to

12 educate the court about such practices. The board cannot always anticipate how an

13 issue will evolve in subsequent judicial review and thus forestall its development.

14 For example, in *Parks v. Fine*, 783 F.2d 1036 (Fed. Cir. 1986), the court modified

15 its opinion after the Office filed an amicus brief explaining that the board did not

16 have the authority to provide the relief the court had ordered. It is dismaying to see

17 the court attribute to the Office generally and to the board particularly practices

18 and attitudes that simply do not exist, particularly in cases where no one from the

19 Office is present to correct the misimpression.

20   Interferences will be around for another two decades. The *Spina* doctrine is

21 creating problems in many, if not most, interferences. If the *Spina* doctrine

22 continues to be the law, it would be helpful to have it re-grounded on a new basis

23 so that it can provide guidance to those who must apply it. Obsolete rules and a

24 misreading of *DeGeorge* provide no useful basis for decision.

Interference 105,775
Connery v. Boucher

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UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

GLENN W. **CONNERY**, GARY JASZEWSKI and RICHARD REID
Junior Party
(Patent 6,246,683)[1]

v.

LAURENCE B. **BOUCHER**, STEPHEN E. BLIGHTMAN, PETER K. CRAFT,
DAVID A. HIGGEN, CLIVE M. PHILBRICK and
DARYL D. STARR
Senior Party
(Application 09/692,561)[2]

_____

Patent Interference No. 105,775
(Technology Center 2400)

_____

Before: JAMESON LEE, RICHARD TORCZON, and JONI Y. CHANG,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

Judgment – Request for Adverse – Bd. R. 127(b)

1 _____

[1]   Based on Application 09/071,692, filed May 1, 1998. The real party in
interest is Hewlett-Packard Company.
[2]   Filed October 18, 2000. The real party in interest is Alacritech, Inc. Accorded
the benefit of Application 09/067,544, filed April 27, 1998, now Patent 6,226,680,
and Provisional Application 60/061,809, filed October 14, 1997.

1   On June 11, 2012, junior party Connery filed a paper requesting entry of

2 adverse judgment. The request is *granted*.

3   It is

4   **ORDERED** that judgment on priority as to Count 1 is entered against junior

5 party GLENN W. CONNERY, GARY JASZEWSKI, and RICHARD REID;

6   **FURTHER ORDERED** that claims 1-3 and 5-20 of junior party's involved

7 Patent 6,246,683, which correspond to Count 1, are herein cancelled;

8   **FURTHER ORDERED** that judgment on priority as to Count 2 is entered

9 against junior party GLENN W. CONNERY, GARY JASZEWSKI, and

10 RICHARD REID;

11   **FURTHER ORDERED** that claim 4 of junior party's involved Patent

12 6,246,683, which corresponds to Count 2, is herein cancelled;

13   **FURTHER ORDERED** that pursuant to our holding of unpatentability of

14 Boucher's claims 46-49, in Paper 262 issued March 26, 2012, Boucher's

15 application claims 46-49 are finally refused;

16   **FURTHER ORDERED** that the parties shall note the requirements of

17 35 U.S.C. §135(c) and Bd.R. 205; and

18   **FURTHER ORDERED** that a copy of this judgment shall be entered into

19 the file of Patent 6,246,683 and Application 09/692,561.

Interference No. 105,775
Connery v. Boucher

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